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December 31, 2004

sal.karottki@goldbergkohn.com
direct phone: 312.201.3861
direct fax: 312.863.7861

VIA EXPRESS MAIL NO. EL873830080US

BOX TTAB/NO FEE
UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

**Re: JACKSON/CHARVEL MANUFACTURING, INC. v. PRINS, LLOYD A.
CANCELLATION NO. 92042614**

Dear Sir or Madam:

Please find enclosed the Petitioner's Motion to Compel and to Test Sufficiency of Response to Admission Requests, along with accompanying Memorandum in Support, in connection with the above-referenced matter (Cancellation No. 92042614).

Please contact me if you have any questions or comments in this regard.

Best regards,



Salvador K. Karottki

SKK.ck

Enclosure

cc: Lloyd A. Prins



01-04-2005

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #74

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)	
Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING,)	Cancellation No. 92042614
INC.,)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A.,)	
Registrant-Respondent.)	

**PETITIONER'S MOTION TO COMPEL AND TO TEST SUFFICIENCY
OF RESPONSE TO ADMISSION REQUESTS**

Petitioner Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel"), by its undersigned attorneys and pursuant to Rules 37 and 36(a) of the Federal Rules of Civil Procedure and Trademark Rule 2.120(e) and (h), hereby moves the Trademark Trial and Appeal Board (the "Board") (i) to compel Respondent Lloyd A. Prins' ("Prins") to fully and completely answer Jackson/Charvel's Interrogatory Nos. 1-7, 10-15, 19, 21, 23, 28, 30, and 31; (ii) to compel Prins to produce documents in response to Jackson/Charvel's Requests for Production Nos. 21-22, 26-30, 37, and 38; and (iii) to deem admitted Jackson/Charvel's Admission Requests Nos. 11, 16, 21, 22, and 38. In support of its Motion, Jackson/Charvel states as follows:

1. On November 1, 2004, Jackson/Charvel timely served Interrogatories, Requests for Production, and Requests for Admission on Prins. A true and correct copy of Jackson/Charvel's Interrogatories to Prins are attached hereto as Exhibit A. A true and correct copy of Jackson/Charvel's Requests for Production are attached hereto as Exhibit B. A true and correct copy of Jackson/Charvel's Admission Requests are attached hereto as Exhibit C.

2. On December 6, 2004, Prins served responses and objections to Jackson/Charvel's discovery requests. A true and correct copy of Prins' Responses to Jackson/Charvel's Interrogatories are attached hereto as Exhibit D. A true and correct copy of Prins Responses to Jackson/Charvel's Requests for Production are attached hereto as Exhibit E. A true and correct copy of Prins' Responses to Jackson/Charvel's Admission Requests are attached hereto as Exhibit F. Prins failed to provide any information in response to a third of Jackson/Charvel's Interrogatories; produced only four pages of documents in response to Jackson/Charvel's Requests for Production; and refused to admit or deny certain straightforward Admission Requests propounded by Jackson/Charvel, opting instead to provide evasive, nonresponsive or qualifying answers.

3. On December 29, 2004, Jackson/Charvel's counsel sent Prins a letter via electronic mail and Federal Express pursuant to Rule 37 detailing his failure to adequately respond to Jackson/Charvel's discovery requests. A true and correct copy of the letter from Jackson/Charvel's counsel to Prins is attached hereto as Exhibit G. Prins confirmed that he received the letter on December 29.

4. On December 30, 2004, Jackson/Charvel's counsel called Prins and spoke with Prins on the telephone. Jackson/Charvel's counsel and Prins spoke about certain of Jackson/Charvel's discovery requests. With regard to certain discovery requests concerning information about Prins' use (including first use) of his trademark, Prins indicated that these requests were "outside of the scope" of Jackson/Charvel's Petition for Cancellation. It was clear to Jackson/Charvel's counsel that Prins disagreed with Jackson/Charvel's position on these issues. Prins and Jackson/Charvel's counsel did not address all of Jackson/Charvel's discovery requests, however, as Prins stated that he had to leave and would be unable to continue the conversation. Prins indicated that he wanted additional time to review Jackson/Charvel's

arguments. Jackson/Charvel's counsel requested that Prins respond later that day or on Friday, December 31; however, Prins said he would not be able to do so. Prins indicated that he would not be able to respond to all of Jackson/Charvel's arguments in its Rule 37 letter until a date that falls after the start of the first testimony period.

5. Jackson/Charvel's counsel conferred with Prins via both correspondence and telephone in a good faith effort to resolve the discovery dispute; however, the parties were unable to reach agreement on resolving the discovery dispute prior to the start of the first testimony period. Jackson/Charvel submits that its discovery requests at issue in this Motion are relevant and that Prins' objections are baseless. Prins' continued suggestions that Jackson/Charvel's discovery requests are "outside of the scope" of Jackson/Charvel's Petition for Cancellation and irrelevant are wholly without merit. However, if the issues raised in Jackson/Charvel's Motion are subsequently resolved by agreement of the parties, Jackson/Charvel will inform the Board in writing of the issues in the Motion which no longer require adjudication.

6. The foregoing issues are discussed more fully in Jackson/Charvel's Memorandum in Support of this Motion, submitted concurrently herewith, and incorporated by reference herein.

WHEREFORE, Jackson/Charvel respectfully requests that the Board grant its Motion in its entirety and:

- (1) compel Prins to fully and completely answer Jackson/Charvel's Interrogatory Nos. 1, 2, 10-15, 19, 21, 23, 28, 30, and 31;
- (2) strike Prins' Affirmative Defenses or, in the alternative, compel Prins to fully and completely answer Jackson/Charvel's Interrogatory Nos. 3-7;
- (3) strike Prins' Affirmative Defenses or, in the alternative, (i) compel Prins to produce all documents responsive to Jackson/Charvel's Requests for Production Nos. 26-30, and (ii) provide descriptions (including author,

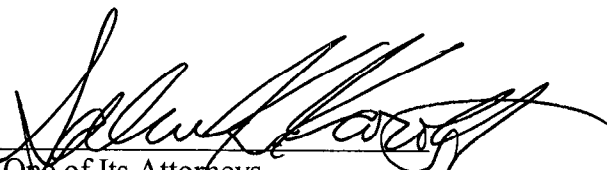
date, recipient, and document type) of any documents withheld on the basis of "work-product immunity and/or other applicable privilege," specifically enumerating the privilege claimed;

- (4) compel Prins to produce documents responsive to Jackson/Charvel's Requests for Production Nos. 21-22, 37, and 38; and
- (5) deem admitted Jackson/Charvel's Admission Requests Nos. 11, 16, 21, 22, and 38.

DATED: December 31, 2004

Respectfully Submitted,

JACKSON/CHARVEL MANUFACTURING,
INC.

By 
One of Its Attorneys

Oscar L. Alcantara
Salvador K. Karottki
GOLDBERG, KOHN, BELL, BLACK,
ROSENBLUM & MORITZ, LTD.
55 East Monroe Street, Suite 3700
Chicago, Illinois 60603
(312) 201-4000

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)	
Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING,)	Cancellation No. 92042614
INC.,)	
)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A.,)	
)	
Registrant-Respondent.)	

PETITIONER'S INTERROGATORY REQUESTS TO RESPONDENT

Petitioner Jackson/Charvel Manufacturing, Inc., by its undersigned attorneys and pursuant to Rule 33 of the Federal Rules of Civil Procedure, hereby requests that Respondent Lloyd A. Prins answer the following interrogatory requests in accordance with the definitions and instructions below:

DEFINITIONS AND INSTRUCTIONS

As used herein, the terms listed below are defined as follows:

1. "Respondent," "Registrant," "Prins," "you," "your," and "his" mean Lloyd A. Prins, the Respondent in this Cancellation Proceeding; any "doing business as" name under which Prins is operating, such as San Dimas Guitars; or any of Prins' agents, employees, attorneys, consultants, or any other person or entity acting or purporting to act on his behalf.

2. "Jackson/Charvel" means Jackson/Charvel Manufacturing, Inc., the Petitioner in this Cancellation Proceeding; its predecessors-in-interest, such as International Music Company ("IMC") and Akai Musical Instruments Corporation ("Akai"); its successors; past or present affiliates; subsidiaries; controlled companies or divisions; and any present or

former officers, directors, representatives, agents, employees, attorneys, consultants, or any other person or entity acting or purporting to act on its behalf.

3. The term "mark" as used herein shall include trademarks, service marks, trade names, or any word or symbol utilized in connection with business activities as defined in 15 U.S.C. § 1127.

4. The conjunctions "and" and "or" shall be interpreted conjunctively and shall not be interpreted disjunctively.

5. "Relating to" means constituting, comprising, containing, setting forth, showing, disclosing, mentioning, describing, explaining, summarizing, pertaining to, concerning or referring to, directly or indirectly.

6. The term "person" or "individual" means any natural person, legal person, government (or agency thereof), a quasi-public entity, or other form of entity, corporation, partnership, trust, unincorporated association, or other entity of any description.

7. As used herein, all plural terms shall include singular, and all singular terms shall include the plural.

8. "Communication" means, without limitation, any meeting, conference, conversation, negotiation, oral or written exchange, or other form of communication, whether face-to-face, by telephone, facsimile, telecopier, letter, e-mail or any other means.

9. "Identify," "identity" or "identification" mean when used in reference to:

A. A natural person, his or her:

- (1) Full name;
- (2) Present or last-known home and business address (including street name and number, city or town, and state) and telephone number; and
- (3) Present or last-known position, business affiliation and job description.

B. A company, corporation, association, partnership or any legal entity other than a natural person, its:

- (1) Full name and type of organization or entity;
- (2) Address of principal place of business; and
- (3) Jurisdiction and date of incorporation of organization, if known.

C. An oral communication:

- (1) The date, time and place when and where it occurred; and
- (2) The identity of each person to whom such communication was made, each person by whom such communication was made, and each person who was present when such communication was made.

D. A piece of correspondence:

The date, author or authors, addressee and subject line.

E. An Agreement:

The signatories, title, and date of the agreement.

F. Any other Document, as defined in Plaintiff's First Set of Requests for Production of Documents and Things, served concurrently herewith:

The author or authors, date, and subject matter and/or title, if any.

10. "Date" means the exact day, month and year if ascertainable; if not exactly ascertainable, then the closest approximation that can be made in terms of days, months and years, seasons, or in relation to other events and matters.

11. These interrogatory requests shall be deemed continuing so as to require supplemental responses in accordance with F.R.C.P. 26(c).

INTERROGATORY REQUESTS

1. Explain how Prins adopted or chose the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark for use in connection with electric guitars.

ANSWER:

2. Describe how Prins chose the logo font for the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark, including all materials reviewed in connection with the design of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark logo.

ANSWER:

3. Explain the entire factual and legal basis for Prins' First Affirmative Defense that Jackson/Charvel's claims are barred by the Doctrine of Laches. Identify all documents and testimony that Prins will offer in connection with his First Affirmative Defense.

ANSWER:

4. Explain the entire factual and legal basis for Prins' Second Affirmative Defense that Jackson/Charvel's claims are barred by the Doctrine of Waiver. Identify all documents and testimony that Prins will offer in connection with his Second Affirmative Defense.

ANSWER:

5. Explain the entire factual and legal basis for Prins' Third Affirmative Defense that Jackson/Charvel's claims are barred by the Doctrine of Estoppel. Identify all documents and testimony that Prins will offer in connection with his Third Affirmative Defense.

ANSWER:

6. Explain the entire factual and legal basis for Prins' Fourth Affirmative Defense that Jackson/Charvel's claims are barred because "its alleged trademark was no more than a token reference to a business mailing address and was not affixed to its products, product tags or packaging." Identify all documents and testimony that Prins will offer in connection with his Fourth Affirmative Defense.

ANSWER:

7. Explain the entire factual and legal basis for Prins' Fifth Affirmative Defense that Jackson/Charvel's claims are barred because Jackson/Charvel "abandoned its alleged trademark." Identify all documents and testimony that Prins will offer in connection with his Fifth Affirmative Defense.

ANSWER:

8. If Prins contends that Jackson/Charvel abandoned its SAN DIMAS mark, identify the period of time that Prins contends Jackson/Charvel did not use the SAN DIMAS mark. Identify all documents and testimony that Prins contends supports the contention that Jackson/Charvel did not use the SAN DIMAS mark at any time.

ANSWER:

9. Identify each and every person, company, or entity that may offer expert testimony in the above captioned proceeding and state after each person: (i) his/her qualifications and current curriculum vitae; (ii) the subject matter on which the expert may be called to testify; (iii) the substance of the fact and opinions to which the expert may be called to testify; and (iv) a summary of the grounds of each opinion.

ANSWER:

10. Identify all persons with knowledge of the facts, issues, or matters relating to this Cancellation Proceeding.

ANSWER:

11. Identify all persons with knowledge of facts supporting Prins' Affirmative Defenses.

ANSWER:

12. Identify all individuals whom Prins has communicated with since June 13, 2003, concerning Jackson/Charvel, Jackson/Charvel's SAN DIMAS mark, Prins' use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark, or this Cancellation Proceeding. After identifying the individual, identify the topic(s) on which Prins communicated with the individual.

ANSWER:

13. Identify all sales of electric guitars bearing or made in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

ANSWER:

14. Identify all the methods through which Prins has marketed, sold, or offered for sale electric guitars bearing or sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

ANSWER:

15. Identify all the ways, if any, in which Prins performed a trademark search before adopting the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY.

ANSWER:

16. Identify each and every communication between Prins and Jackson/Charvel concerning any mark containing the terms "SAN DIMAS" since October 24, 2002.

ANSWER:

17. If Prins claims that his mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY is not likely to be confused with Jackson/Charvel's SAN DIMAS mark, identify any and all facts or legal grounds for this contention.

ANSWER:

18. Identify all uses, if any, of any mark containing in whole or in part the terms "SAN DIMAS" that Prins believes is relevant to this dispute, identifying who is using the mark, when the mark was first used and where, the products or services with which the mark is used, the manner in which the mark is used, and the evidence that Prins has that demonstrates any of these facts.

ANSWER:

19. Identify any and all mark searches or surveys performed by Prins at any time and the dates on which such searches or surveys were performed.

ANSWER:

20. Identify and describe each and every product sold or marketed in connections with Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

ANSWER:

21. Identify the date(s) on which Prins became aware that Jackson/Charvel used the mark SAN DIMAS in any format whatsoever.

ANSWER:

22. Identify all individuals who may be used at trial or during any hearing to present evidence as a fact witness on Prins' behalf, including the topics on which such persons will testify and the specific testimony or evidence they will offer.

ANSWER:

23. Describe and explain Prins' understanding of and contentions relating to when and how Jackson/Charvel used the mark SAN DIMAS.

ANSWER:

24. Explain and describe the type of customer that Prins is targeting or targeted with his electric guitars sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

ANSWER:

25. Identify the grounds for Prins' contentions, if any, that the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is distinctive.

ANSWER:

26. Describe and explain Prins' understanding of the location of Jackson/Charvel's manufacturing plant or plants for SAN DIMAS brand guitars.

ANSWER:

27. Identify all employees, consultants, or individuals related to or involved with Prins' marketing, sale, or offering for sale of guitars sold in connection with the SAN DIMAS

GUITARS THE CALIFORNIA GUITAR COMPANY
mark.

ANSWER:

28. Describe Prins' entire employment history, including any and all companies that Prins has been employed by, the positions held at those companies, and the dates of such employment.

ANSWER:

29. Identify all individuals involved in the development of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

ANSWER:

30. Identify and describe Prins' first use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

ANSWER:

31. Identify each time that Prins purchased a Jackson/Charvel guitar from the custom shop, including the date and model number of the guitar purchased.

ANSWER:

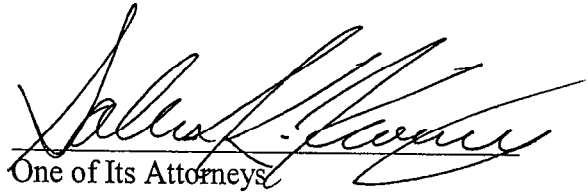
32. Provide the name, address, and telephone number of all individuals preparing, assisting in the preparation of, or providing information in response to Jackson/Charvel's Interrogatory Requests, identifying the interrogatory or interrogatories for which the assistance or information was provided and the specific information or assistance provided.

ANSWER:

DATED: November 1, 2004

JACKSON/CHARVEL MANUFACTURING,
INC.

By



One of Its Attorneys

Oscar L. Alcantara
Salvador K. Karottki
GOLDBERG, KOHN, BELL, BLACK,
ROSENBLUM & MORITZ, LTD.
55 East Monroe Street, Suite 3700
Chicago, Illinois 60603
(312) 201-4000
Attorneys for Jackson/Charvel Manufacturing, Inc.

CERTIFICATE OF SERVICE

I, Salvador K. Karottki, an attorney, hereby certify that I caused **Petitioner's**
Interrogatory Requests to Respondent to be served upon:

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, California 91208

by causing a copy of same to be sent via Federal Express (overnight courier) on November 1,
2004.


Salvador K. Karottki

EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)	
Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING,)	Cancellation No. 92042614
INC.,)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A.,)	
Registrant-Respondent.)	

PETITIONER'S REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS

Petitioner Jackson/Charvel Manufacturing, Inc., by its undersigned attorneys and pursuant to Rule 34 of the Federal Rules of Civil Procedure, hereby requests that Petitioner Lloyd A. Prins hereby respond to the following requests for production of documents and things and produce the following documents for inspection and copying in accordance with the definitions and instructions below:

DEFINITIONS AND INSTRUCTIONS

As used herein, the terms listed below are defined as follows:

1. "Respondent," "Registrant," "Prins," "you," "your," and "his" mean Lloyd A. Prins, the Respondent in this Cancellation Proceeding; any "doing business as" name under which Prins is operating, such as San Dimas Guitars; or any of Prins' agents, employees, attorneys, consultants, or any other person or entity acting or purporting to act on his behalf.

2. "Jackson/Charvel" means Jackson/Charvel Manufacturing, Inc., the Petitioner in this Cancellation Proceeding; its predecessors-in-interest, such as International Music Company ("IMC") and Akai Musical Instruments Corporation ("Akai"); its successors;

past or present affiliates; subsidiaries; controlled companies or divisions; and any present or former officers, directors, representatives, agents, employees, attorneys, consultants, or any other person or entity acting or purporting to act on its behalf.

3. The term "mark" as used herein shall include trademarks, service marks, trade names, or any word or symbol utilized in connection with business activities as defined in 15 U.S.C. § 1127.

4. The conjunctions "and" and "or" shall be interpreted conjunctively to include any information otherwise within the scope of the Document Request, and shall not be interpreted disjunctively.

5. "Relating to" or "referring to" means constituting, comprising, containing, setting forth, showing, disclosing, mentioning, describing, explaining, summarizing, pertaining to, concerning or referring to, directly or indirectly.

6. "Communication" means, without limitation, any meeting, conference, conversation, negotiation, oral or written exchange, or other form of communication, whether face-to-face, by telephone, facsimile, telecopier, letter, e-mail or any other means.

7. The term "person" or "individual" means any natural person, legal person, government (or agency thereof), a quasi-public entity, or other form of entity, corporation, partnership, trust, unincorporated association, or other entity of any description.

8. "Documents" means all writings or records of every kind in your custody, possession or control or in the custody, possession or control of any agent, employee or representative (including advertising agencies, marketing firms, attorneys and accountants) of yours including, but not limited to, letters, e-mails telegrams, telex messages, story boards, memoranda, reports, drawings, studies, calendar or diary entries, maps, plans, pamphlets, notes or records of meetings or conversations of any kind, charts, tabulations, analyses, statistical or

information accumulations, financial statements, bills, receipts, work orders, purchase orders, invoices, canceled checks, general ledgers, accounting records of any kind, film impressions, photographs, video tapes, computer files, tape recordings, archive and data storage tapes, computer and data disks, computer printouts (and electronic or other materials from which such printouts may be obtained), magnetic tapes, mechanical reproductions (of sound, data or visual information), as well as drafts, revisions, amendments or supplements of the above, and copies of documents that are not identical duplicates of the originals (because, e.g., handwritten or "blind" notes appear thereon or are attached thereto.)

9. "Date" means the exact day, month and year if ascertainable; if not exactly ascertainable, then the closest approximation that can be made in terms of days, months and years, seasons, or in relation to other events and matters.

10. As used herein, all plural terms shall include singular, and all singular terms shall include the plural.

11. If any privilege is claimed with respect to any documents responsive to these requests, state the nature of the privilege claimed, all facts relied upon in support of the claim, identify all documents related to the claim and identify all persons having any knowledge of any facts related to the claim.

12. If any document called for by a request is no longer in existence, describe the document and state how, when, why and by whom it was destroyed.

13. These document requests shall be deemed continuing so as to require supplemental responses in accordance with F.R.C.P. 26(c).

REQUESTS FOR PRODUCTION

1. All documents relating or referring to Jackson/Charvel and its SAN DIMAS mark.

RESPONSE:

2. All documents relating or referring to Prins' adoption of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE:

3. All documents relating to any mark search performed at any time by Prins.

RESPONSE:

4. All documents that evidence or reflect Prins' use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE:

5. All documents relating to any other marks that Prins contemplated using in connection with his guitars other than the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE:

6. All documents relating or referring to or consisting of advertisements for Prins' guitar products sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE:

7. All documents relating or referring to the mark SAN DIMAS.

RESPONSE:

8. All documents relating to this Cancellation Proceeding or any advice received from others concerning this Cancellation Proceeding.

RESPONSE:

9. All correspondence and documents concerning any communications with other individuals concerning Jackson/Charvel's SAN DIMAS mark or this Cancellation Proceeding.

RESPONSE:

10. All cases, materials, research, or other documents that Prins has collected in order to prepare for this Cancellation since June 13, 2003.

RESPONSE:

11. All documents relating or referring to or constituting any evidence of actual confusion, alleged or claimed confusion, or the appearance of confusion regarding Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand products and Jackson/Charvel's SAN DIMAS brand products or any other product.

RESPONSE:

12. All documents constituting or referring or relating to your communications with third parties regarding your selection, advertising, promotion, naming and/or use of the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY.

RESPONSE:

13. All documents referring or relating to the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY.

RESPONSE:

14. Statements, signed or unsigned, from any person having or purporting to have knowledge or information concerning the subject matter of this Cancellation Proceeding.

RESPONSE:

15. All documents that refer or relate to any communication received by you that your use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark in any form or style, causes confusion, is likely to cause confusion, or dilutes any mark.

RESPONSE:

16. All documents used in connection with Prins' answers to Jackson/Charvel's Interrogatory Requests.

RESPONSE:

17. All documents that Prins has identified or has been requested to identify in response to Jackson/Charvel's Interrogatory Requests.

RESPONSE:

18. All documents that Prins intends to offer as evidence in this Cancellation Proceeding.

RESPONSE:

19. All sales receipts, invoices, or documents relating to sales of Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand products.

RESPONSE:

20. All documents relating to Jackson/Charvel's warranty policies.

RESPONSE:

21. All documents concerning any agreements Prins has or had with Jackson/Charvel.

RESPONSE:

22. All invoices, receipts, and documents relating to Prins' purchase of guitars from the Jackson/Charvel custom shop.

RESPONSE:

23. All invoices, receipts, and documents relating to Prins' purchase of SAN DIMAS brand guitars from Jackson/Charvel.

RESPONSE:

24. All invoices, receipts, and documents relating to Prins' purchase of guitars containing SAN DIMAS brand necks from Jackson/Charvel.

RESPONSE:

25. All documents referring or relating to communications with Jackson/Charvel concerning the SAN DIMAS mark.

RESPONSE:

26. All documents relating to Prins' First Affirmative Defense or the subject matter of such Affirmative Defense.

RESPONSE:

27. All documents relating to Prins' Second Affirmative Defense or the subject matter of such Affirmative Defense.

RESPONSE:

28. All documents relating to Prins' Third Affirmative Defense or the subject matter of such Affirmative Defense

RESPONSE:

29. All documents relating to Prins' Fourth Affirmative Defense or the subject matter of such Affirmative Defense

RESPONSE:

30. All documents relating to Prins' Fifth Affirmative Defense or the subject matter of such Affirmative Defense

RESPONSE:

31. All documents relating to Prins' choice or use of font for the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark logo.

RESPONSE:

32. All documents relating to Prins' first use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE:

33. All advertisements, posters, or point-of-sale displays relating to Jackson/Charvel's SAN DIMAS brand guitars.

RESPONSE:

34. All articles, including all newspaper and magazine articles, referencing Jackson/Charvel's SAN DIMAS mark of SAN DIMAS brand guitars.

RESPONSE:

35. All articles, including all newspaper and magazine articles, referencing Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark of SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand guitars.

RESPONSE:

36. Any consumer or market surveys or documents relating to such surveys relating to the SAN DIMAS and SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY marks or the SAN DIMAS and SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand products.

RESPONSE:

37. All documents received from the United States Patent and Trademark Office and documents sent to the United States Patent and Trademark Office relating to the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE:

38. All documents relating to or consisting of any communication concerning obtaining registration of or registration of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE:

39. An example of a SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand guitar.

RESPONSE:

40. All advertisements or mock-ups for advertisements for Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand guitars.

RESPONSE:

41. All documents relating to communications with any other individuals, including PR agencies or marketing firms or consultants, concerning the marketing of SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand guitars.

RESPONSE:

42. Any opinions concerning whether Prins can or cannot use the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark or concerning whether Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to be confused with Jackson/Charvel's SAN DIMAS mark.


RESPONSE:

43. All documents that Prins believes support his positions in this Cancellation Proceeding.

RESPONSE:

DATED: November 1, 2004

JACKSON/CHARVEL MANUFACTURING,
INC.

By 
One of Its Attorneys


Oscar L. Alcantara
Salvador K. Karottki
GOLDBERG, KOHN, BELL, BLACK,
ROSENBLOOM & MORITZ, LTD.
55 East Monroe Street, Suite 3700
Chicago, Illinois 60603
(312) 201-4000
Attorneys for Jackson/Charvel Manufacturing, Inc.

CERTIFICATE OF SERVICE

I, Salvador K. Karottki, an attorney, hereby certify that I caused **Petitioner's**
Requests for Production of Documents and Things to be served upon:

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, California 91208

by causing a copy of same to be sent via Federal Express (overnight courier) on November 1,
2004.



Salvador K. Karottki

EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)
Trademark Registration No. 2,772,766)
For the Mark SAN DIMAS GUITARS THE)
CALIFORNIA GUITAR COMPANY (Design))
Registration Date: October 7, 2003)
JACKSON/CHARVEL MANUFACTURING,)
INC.,)
Petitioner,)
v.)
PRINS, LLOYD A.,)
Registrant-Respondent.)

Cancellation No. 92042614

PETITIONER'S REQUESTS FOR ADMISSION TO RESPONDENT

Petitioner Jackson/Charvel Manufacturing, Inc., by its undersigned attorneys and pursuant to Rule 36 of the Federal Rules of Civil Procedure, hereby requests that Respondent Lloyd A. Prins admit the following matters in accordance with the definitions and instructions below:

DEFINITIONS AND INSTRUCTIONS

As used herein, the terms listed below are defined as follows:

1. "Respondent," "Registrant," "Prins," "you," "your," and "his" mean Lloyd A. Prins, the Respondent in this Cancellation Proceeding; any "doing business as" name under which Prins is operating, such as San Dimas Guitars; or any of Prins' agents, employees, attorneys, consultants, or any other person or entity acting or purporting to act on his behalf.

2. "Jackson/Charvel" means Jackson/Charvel Manufacturing, Inc., the Petitioner in this Cancellation Proceeding; its predecessors-in-interest, such as International Music Company ("IMC") and Akai Musical Instruments Corporation ("Akai"); its successors; past or present affiliates; subsidiaries; controlled companies or divisions; and any present or

former officers, directors, representatives, agents, employees, attorneys, consultants, or any other person or entity acting or purporting to act on its behalf.

3. The term "mark" as used herein shall include trademarks, service marks, trade names, or any word or symbol utilized in connection with business activities as defined in 15 U.S.C. § 1127.

4. The conjunctions "and" and "or" shall be interpreted conjunctively and shall not be interpreted disjunctively.

5. As used herein, all plural terms shall include singular, and all singular terms shall include the plural.

6. If you fail to admit the genuineness of any document or the truth of any matter requested, and the requesting party proves the genuineness of the document or the truth of the matter, the requesting party shall be entitled to recover the reasonable expenses incurred in making that proof, including reasonable attorneys' fees.

7. These Requests for Admissions are continuing, and to the extent that the answers may be enlarged, diminished, or otherwise modified by information acquired subsequent to the service of your answers, you are requested to serve promptly supplemental answers reflecting each change.

REQUESTS FOR ADMISSION

1. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars as early as 1993.

ANSWER:

2. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1994.

ANSWER:

3. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1995.

ANSWER:

4. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1996.

ANSWER:

5. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1997.

ANSWER:

6. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1998.

ANSWER:

7. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1999.

ANSWER:

8. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2000.

ANSWER:

9. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2001.

ANSWER:

10. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2002.

ANSWER:

11. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2003.

ANSWER:

12. Jackson/Charvel has continuously used the SAN DIMAS mark in connection with the sale of guitars from 1993 to the present.

ANSWER:

13. Jackson/Charvel has sold in the United States tens to hundreds of thousands of dollars worth of electric guitar products using the SAN DIMAS mark.

ANSWER:

14. Jackson/Charvel's SAN DIMAS mark has acquired distinctiveness amongst consumers of guitars.

ANSWER:

15. Based on Jackson/Charvel's use and promotion of the SAN DIMAS mark with respect to electric guitars, the SAN DIMAS mark has acquired goodwill and public recognition among relevant consumers, the industry, and the purchasing public.

ANSWER:

16. Jackson/Charvel has not authorized Prins to incorporate the SAN DIMAS mark into any of Prins' marks.

ANSWER:

17. Prins' SAN DIMAS logo mark, pictured below, was substantially copied from a Jackson/Charvel SAN DIMAS logo:

San Dimas

ANSWER:

18. Prins was aware of Jackson/Charvel's SAN DIMAS mark when he design his SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark logo.

ANSWER:

19. When Jackson/Charvel was selling SAN DIMAS brand guitars, the SAN DIMAS mark had obtained acquired distinctiveness.

ANSWER:

20. From 1997 to 2002, purchasers of electric guitars associated the SAN DIMAS mark with Jackson/Charvel.

ANSWER:

21. Jackson/Charvel has not authorized Prins to use the SAN DIMAS mark.

ANSWER:

22. Jackson/Charvel has not authorized Prins to use the SAN DIMAS mark in connection with Prins' guitar products.

ANSWER:

23. Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to cause confusion, or to cause mistake, or to deceive consumers with respect to Jackson/Charvel's SAN DIMAS mark..

ANSWER:

24. The continued registration of Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark will cause injury and damage to Jackson/Charvel.

ANSWER:

25. Jackson/Charvel used its SAN DIMAS mark prior to Prins' use of any mark incorporating the terms "SAN DIMAS."

ANSWER:

26. Jackson/Charvel used its SAN DIMAS mark in connection with the sale of electric guitars.

ANSWER:

27. Jackson/Charvel used its SAN DIMAS mark in point-of-sale displays associated with its SAN DIMAS brand electric guitars.

ANSWER:

28. Prins has purchased one or more SAN DIMAS brand guitars from Jackson/Charvel.

ANSWER:

29. Jackson/Charvel provides warranty services for its SAN DIMAS brand guitars.

ANSWER:

30. The SAN DIMAS mark is associated in the guitar industry with Jackson/Charvel.

ANSWER:

31. Prins owns one or more SAN DIMAS brand guitars made by Jackson/Charvel.

ANSWER:

32. Prins has had access to Jackson/Charvel's advertising of its SAN DIMAS brand electric guitars.

ANSWER:

33. Prins purchased a SAN DIMAS guitar in 2002 from Jackson/Charvel.

ANSWER:

34. Prins owns guitars with SAN DIMAS brand necks purchased from Jackson/Charvel after 1999.

ANSWER:

35. Jackson/Charvel's SAN DIMAS brand guitars were never produced in San Dimas, California.

ANSWER:

36. Jackson/Charvel has continuously used the SAN DIMAS mark since 1995.

ANSWER:

37. Prins adopted the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark in order to associate him with Jackson/Charvel.

ANSWER:

38. Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to cause confusion with Jackson/Charvel's SAN DIMAS mark.

ANSWER:

39. Jackson/Charvel has protectible trademark rights in the SAN DIMAS mark.

ANSWER:

40. The SAN DIMAS mark is distinctive.

ANSWER:

41. The SAN DIMAS mark is strong.

ANSWER:

42. Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is very similar in sight, sound, and meaning to Jackson/Charvel's SAN DIMAS mark

ANSWER:

43. Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark contains all of Jackson/Charvel's SAN DIMAS mark.

ANSWER:

44. The dominant portions of Prins' mark and Jackson/Charvel's mark is "SAN DIMAS."

ANSWER:

45. The dominant portions of Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark and Jackson/Charvel's SAN DIMAS mark are identical.

ANSWER:

46. The goods description for Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is "electric guitars and electric basses."

ANSWER:

47. The goods description for Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is identical to the goods with which Jackson/Charvel uses the SAN DIMAS mark in connection.

ANSWER:

48. Prins markets and sells products using the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark to the same consumer market as Jackson/Charvel's guitars.

ANSWER:

49. Prins markets and sells products using the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark through the same trade channels as Jackson/Charvel uses to sell its guitars.

ANSWER:

50. Prior to 1997, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

51. Prior to 1998, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

52. Prior to 1999, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

53. Prior to 2000, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

54. Prior to 2001, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

55. Prior to 2002, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

56. Prior to 2003, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

57. During 2003, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

58. During 2004, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

ANSWER:

59. Prins knowingly chose a mark containing the terms "SAN DIMAS" even though the SAN DIMAS mark is associated with Jackson/Charvel.

ANSWER:

60. The SAN DIMAS mark has secondary meaning among guitar consumers.

ANSWER:

61. Jackson/Charvel builds SAN DIMAS brand guitars in its custom shop.

ANSWER:

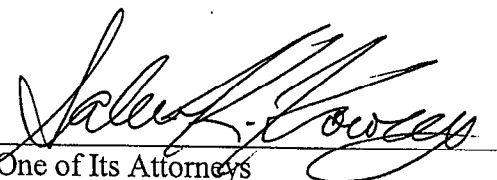
62. Jackson/Charvel has built and marketed SAN DIMAS brand guitars every year since 1993.

ANSWER:

DATED: November 1, 2004

JACKSON/CHARVEL MANUFACTURING,
INC.

By


One of Its Attorneys

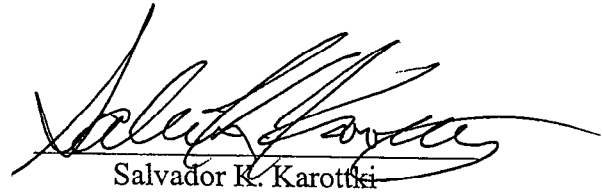
Oscar L. Alcantara
Salvador K. Karottki
GOLDBERG, KOHN, BELL, BLACK,
ROSENBLUM & MORITZ, LTD.
55 East Monroe Street, Suite 3700
Chicago, Illinois 60603
(312) 201-4000
Attorneys for Jackson/Charvel Manufacturing, Inc.

CERTIFICATE OF SERVICE

I, Salvador K. Karottki, an attorney, hereby certify that I caused **Petitioner's**
Requests for Admission to Respondent to be served upon:

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, California 91208

by causing a copy of same to be sent via Federal Express (overnight courier) on November 1,
2004.



Salvador K. Karottki

EXHIBIT D

RECEIVED

DEC 07 2004

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of
Trademark Registration No. 2,772,766
For the Mark SAN DIMAS GUITARS THE
CALIFORNIA GUITAR COMPANY
Registration Date: October 7, 2003

JACKSON/CHARVEL MANUFACTURING,
INC.,

Cancellation No. 92042614

Petitioner,

v.

PRINS, LLOYD A.,

Registrant

To: Salvador K. Karottki
Goldberg, Kohn
55 East Monroe Street, Suite 3700
Chicago, IL 60603

**REGISTRANT'S RESPONSE TO
PETITIONER'S INTERROGATORY REQUESTS TO RESPONDENT**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and the Trademark Rule 2.119(c), Registrant Lloyd A. Prins hereby answers Petitioner's Interrogatory Requests To Respondent.

GENERAL OBJECTION

Registrant objects to the term "doing business as" as used in **Petitioner's Definitions And Instructions** as this term is vague, ambiguous and not likely to lead to admissible evidence in support of Petitioner's pleadings in its Petition for Cancellation.

Registrant's answers to these interrogatories are based on information available to Registrant at the time of completion and Registrant reserves the right to revise, correct or

supplement its answers and/or objections following the discovery or development of additional information.

INDIVIDUAL RESPONSES

1. Explain how Prins adopted or chose the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark for use in connection with electric guitars.

Answer: Registrant objects to this discovery request: An explanation of how Registrant adopted or chose SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY as the trademark for Registrant's San Dimas Guitar Company requires Registrant to disclose proprietary and confidential information. Furthermore, this request seeks to discover information that is outside the scope of Petitioner's pleadings in its Petition For Cancellation and is therefore not likely to lead to admissible evidence.

2. Describe how Prins chose the logo font for the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark, including all materials reviewed in connection with the design of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark logo.

Answer: Registrant objects to this discovery request: A description of how Registrant chose a logo font for the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY trademark for Registrant's San Dimas Guitar Company seeks to discover information that is outside the scope of Petitioner's pleadings in its Petition For Cancellation and is therefore not likely to lead to admissible evidence.

3. Explain the entire factual and legal basis for Prins' First Affirmative Defense that Jackson/Charvel's claims are barred by the Doctrine of Laches. Identify all documents and testimony that Prins will offer in connection with his First Affirmative Defense.

Answer: Registrant contends that Petitioner was negligent in establishing and maintaining a claim to a trademark that included the term "San Dimas" in whole or in

part. The factual basis for this argument is found in the following documents that Registrant intends to rely in support of this defense:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents provided by Petitioner in response to Registrant's discovery requests.

Registrant will rely on his own testimony in connection with this defense.

4. Explain the entire factual and legal basis for Prins' Second Affirmative Defense that Jackson/Charvel's claims are barred by the Doctrine of Waiver. Identify all documents and testimony that Prins will offer in connections with his Second Affirmative Defense.

Answer: Registrant believes that through Petitioner's actions, Petitioner waived any and all rights to a trademark that included the term San Dimas in whole or in part. The factual basis for this argument is found in the following documents that Registrant intends to rely in support of this defense:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents provided by Petitioner in response to Registrant's discovery requests.

Registrant will rely on his own testimony in connection with this defense.

5. Explain the entire factual and legal basis for Prins' Third Affirmative Defense that Jackson/Charvel's claims are barred by the Doctrine of Estoppel. Identify all documents and testimony that Prins will offer in connections with his Third Affirmative Defense.

Answer: Registrant contends that after Petitioner learned of Registrant's San Dimas Guitar Company and Registrant's registration of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY trademark, Petitioner has made several changes in the conduct and treatment of Petitioner's use of the a San Dimas mark and that these changes were made with the deliberate intent of causing harm to Registrant. The factual basis for this argument is found in the following documents that Registrant intends to rely in support of this defense:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents provided by Petitioner in response to Registrant's discovery requests.

Registrant will rely on his own testimony in connection with this defense.

6. Explain the factual and legal basis for Prins' Fourth Affirmative Defense that Jackson/Charvel's claims are barred because "its alleged trademark was no more than a token reference to a business mailing address and was not affixed to its products, product tags or packaging." Identify all documents and testimony that Prins will offer in connection with his Fourth Affirmative Defense.

Answer: Registrant's legal argument for its Fourth Affirmative defense is found in 15 U.S.C. §1127 and the TMEP §901.01, §901.02, and §904.05 ¶2. The factual basis for this argument is found in the following documents that Registrant intends to rely in support of this defense:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents provided by Petitioner in response to Registrant's discovery requests.

Registrant will rely on his own testimony in connection with this defense.

By pleading this defense, Registrant expressly does not acknowledge that Petitioner has established any use or protections for use in the San Dimas mark.

- 7 Explain the entire factual and legal basis for Prins' Fifth Affirmative Defense that Jackson/Charvel's claims are barred because Jackson/Charvel "abandoned its alleged trademark." Identify all documents and testimony that Prins will offer in connection with his Fifth Affirmative Defense.

Answer: Registrant's legal argument for its Fifth Affirmative defense is found in 15 U.S.C. §1127 (definition "abandonment of a mark"). The factual basis for this argument is found in the following documents that Registrant intends to rely in support of this defense:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents that are a part of the record in this proceeding
- f) All documents provided by Petitioner in response to Registrant's discovery requests.

Registrant will rely on his own testimony in connection with this defense.

By pleading this defense, Registrant expressly does not acknowledge that Petitioner has established any use or protections for use in the San Dimas mark.

8. If Prins contends that Jackson/Charvel abandoned its SAN DIMAS mark, identify the period of time that Prins contends Jackson/Charvel did not use the SAN DIMAS mark. Identify all documents and testimony that Prins contends supports the contention that Jackson/Charvel did not use the SAN DIMAS mark at any time.

Answer: Registrant's affirmative defense that Petitioner abandoned the San Dimas mark is based on the 1995 and 1996 Jackson/Charvel product catalogs that were provided to Registrant by Petitioner. On at least two occasions, Registrant requested of Petitioner to provide any and all documents that support Petitioner's claim to rights in the San Dimas mark. Since Petitioner only produced these two catalogs, Registrant concluded that use of the term "San Dimas" could not be supported by samples, documents or any other evidence beyond the year 1996. Registrant does not believe that the use of the term "San Dimas" in Petitioner's 1995 and 1996 catalogs passes the "use in commerce" test or "specimen" test as defined by 15 U.S.C. §1127 and the TMEP §901.01, §901.02, and §904. Furthermore, if Petitioner's 1995 and 1996 catalogs could pass these tests, Registrant relies on 15 U.S.C. §1127 (definition "abandonment of a mark") which states "Nonuse for 3 consecutive years shall be prima facie evidence of abandonment."

Registrant intends to rely on the following documents in support of this response:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents that are a part of the record in this proceeding

- f) All documents provided by Petitioner in response to Registrant's discovery requests.

Registrant will rely on his own testimony in connection with this response.

9. Identify each and every person, company, or entity that may offer expert testimony in the above captioned proceeding and state after each person: (i) his/her qualifications and current curriculum vitae; (ii) the subject matter on which the expert may be called to testify; (iii) the substance of the fact and opinions to which the expert may be called to testify; and (iv) a summary of the grounds of each opinion.

Answer: At the time of preparing this response, Registrant has neither talked with nor engaged the services of any individual, company or entity that will offer expert testimony on Registrant's behalf in the above captioned proceeding.

10. Identify all persons with knowledge of the facts, issues, or matters relating to this Cancellation Proceeding.

Answer: Registrant objects to this request, as it is vague, ambiguous and overly broad.

11. Identify all persons with knowledge of facts supporting Prins' Affirmative Defenses.

Answer: Registrant objects to this request, as it is vague, ambiguous, overly broad, and otherwise nonsensical and not reasonably capable of discernment.

12. Identify all individuals whom Prins has communicated with since June 13, 2003, concerning Jackson/Charvel, Jackson/Charvel's SAN DIMAS mark, Prins' use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark, or this Cancellation Proceeding. After identifying the individual, identify the topic(s) on which Prins communicated with the individual.

Answer: Registrant objects to this request, as it requires the disclosure of confidential information. Additionally, Registrant objects because this request is outside the scope of Petitioner's pleadings and not likely to lead to admissible evidence in support of any pleadings in Petitioner's Petition For Cancellation. Without waiving these objections, Respondent states that in the course of conducting day-to-day business, Registrant

communicates with tens of hundreds of people over a year's time. Such communications include customers, vendors, potential customer and potential vendors.

13. Identify all sales of electric guitars bearing or made in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

Answer: Registrant objects to this request because it requests confidential and/or proprietary information. Additionally, this request seeks to discover information that is not likely to lead to admissible evidence in support of any pleading made in Petitioner's Petition For Cancellation.

14. Identify all methods through which Prins has marketed, sold, or offered for sale electric guitars bearing or sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

Answer: Registrant objects to the disclosure of the marketing and selling methods employed by Registrant and the San Dimas Guitar Company, as such a reply requires Registrant to disclose information that is of a competitive and confidential nature. Registrant also objects to this request because is not likely to lead to admissible evidence as it requests information that is outside the scope of Petitioner's pleadings in its Petition For Cancellation.

15. Identify all the ways, if any, in which Prins performed a trademark search before adopting the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

Answer: Registrant object to this request as it assumes facts not in evidence. Additionally, a reply to this request is not likely to lead to any admissible evidence that could be used in support of Petitioner's pleadings and its Petitioner's Petition For Cancellation.

16. Identify each and every communication between Prins and Jackson/Charvel concerning any mark containing the terms "SAN DIMAS" since October 24, 2002.

Answer: Registrant has had the following communications with Petitioner:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins
- d) Prins email to Mark VanVleet July 25, 2003
- e) Prins letter to Mark VanVleet September 2, 2003
- f) Registrant's Answer to Petitioner's Petition For Cancellation
- g) Registrant's First Discovery Requests served upon Petitioner
- h) Petitioner's responses to Registrant's First Discovery Requests
- i) Registrant's November 13, 2004 letter to Salvador K. Karottki
- j) Registrant's telephone call with Salvador Karottki November 23, 2004
- k) Registrant's email to Salvador Korottki November 23, 2004
- l) Registrant's replies to Petitioner's discovery requests

17. If Prins claims that his mark SAN DIMAS GUITARS THE CALFIORNIA GUITAR COMPANY is not likely to be confused with Jackson/Charvel's SAN DIMAS mark, identify any and all facts or legal grounds for this contention.

Answer: Registrants denies that his use of the San Dimas mark will cause confusion, mistakes or deceive consumers by reason that Registrant's mark is senior to Petitioner's alleged mark. Petitioner's use of the San Dimas mark occurred only after Petitioner learned of the existence of Registrant's San Dimas Guitar Company and Registrant's application for registration of the San Dimas trademark. Furthermore, Registrant contends that Petitioner's July 2003 unveiling of the first ever Jackson/Charvel product to incorporate the term "San Dimas" physically affixed to a guitar was done in bad faith and for the purpose of restricting competition. Registrant contends that Petitioner's continued

use of the term "San Dimas" in any form will cause mistakes and confusion to Registrant with respect to products manufactured and sold by Registrant and his San Dimas Guitar Company and that Registrant will be harmed by this unauthorized use.

18. Identify all uses, if any, of any mark containing in whole or in part the terms "SAN DIMAS" that Prins believes is relevant to this dispute, identifying who is using the mark, when the mark was first used and where, the products or services with which the mark is used, the manner in which the mark is used, and the evidence that Prins has that demonstrates any of these facts.

Answer: Registrant believes that only the two images shown below are relevant to the above-cited proceeding. The mark identified as letter "A" is currently in use by the San Dimas Guitar Company, a company owned and operated by Registrant. The image identified as letter "B" was used by Petitioner in its twenty-fifth anniversary Charvel guitar.



A



B

By offering this response, Registrant expressly does not admit that the image identified by letter "B" constitutes a trademark (as defined by U.S.C. §1127 and the TMEP §901.01, §901.02, and §904).

19. Identify any and all mark searches or surveys performed by Prins at any time and the dates on which such searches or surveys were performed.

Answer: Registrant object to this request as it assumes facts not in evidence.

Additionally, this request is outside the scope of Petitioner's pleadings and a reply is not likely to lead to any admissible evidence that Petitioner could use in support of its Petition For Cancellation.

20. Identify and describe each and every product sold or marketed in connections with Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

Answer: Registrant objects to this request, as it requires the disclosure of confidential information. Additionally, Registrant objects to this request because it is outside the scope of Petitioner's pleadings and is not likely to lead to admissible evidence in support of Petitioner's Petition For Cancellation.

21. Identify the dates(s) on which Prins became aware that Jackson/Charvel used the mark SAN DIMAS in any format whatsoever.

Answer: Registrant first became aware of Petitioner's first attempted use of the San Dimas mark at the 2003 Summer NAMM Show in Nashville, TN. The date was July 2003.

22. Identify all individuals who may be used at trial or during any hearing to present evidence as a fact witness on Prins' behalf, including the topics on which such persons will testify and the specific testimony or evidence they will offer.

Answer: At the time of preparing this response, Registrant has neither talked with nor engaged any individual, company or entity that will offer testimony on Registrant's behalf in the above captioned proceeding.

23. Describe and explain Prins' understanding of and contentions relating to when and how Jackson/Charvel used the mark SAN DIMAS.

Answer: Petitioner's first attempted use of the term "San Dimas" in a trademark occurred in July of 2003 at the Summer NAMM Show in Nashville, TN. At this show, Petitioner displayed an electric guitar that was branded with the "Charvel" trademark (U.S. Trademark Registration No. 1373706). Above the Charvel trademark was a decal the size of a quarter coin that read "San Dimas 25th Anniversary" (refer to Registrant's answer no. 18 above).

The unveiling of this Charvel 25th Anniversary guitar occurred only after Petitioner learned of the existence of Registrant's San Dimas Guitar Company and Registrant's application for registration of the San Dimas trademark. Furthermore, Registrant contends that Petitioner's release of this first ever Jackson/Charvel product to have the term "San Dimas" physically affixed to a guitar was done in bad faith and for the purpose of restricting competition. Registrant contends that Petitioner's continued use of the term "San Dimas" in any form will cause mistakes and confusion with respect to products manufactured and sold by Registrant and his San Dimas Guitar Company.

24. Explain and describe the type of customer that Prins is targeting or targeted with his electric guitars sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

Answer: Individuals who purchase electric guitars, male or female, ages 12 and beyond.

25. Identify the grounds for Prins' contentions, if any, that the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is distinctive.

Answer: Registrant objects to this request because it seeks to discover information that is outside the scope of Petitioner's pleadings in its Petition For Cancellation and therefore not likely to lead to admissible evidence in the above captioned proceeding. Without waiving this objection, Registrant states that San Dimas guitars are distinctive from any other guitar in that each and every San Dimas guitar manufactured at Registrant's San Dimas Guitar Company is branded with a three-inch logo that reads "San Dimas". This logo is prominently displayed on front headstock area of the guitar and is easily read from a long distance. Registrant contends that this branding is unique from any other guitar ever produced and is distinct to products manufactured and sold by Registrant through his San Dimas Guitar Company.

26. Describe and explain Prins' understanding of the location of Jackson/Charvel's manufacturing plant or plants for SAN DIMAS brand guitars.

Answer: Registrant contends that the only product manufactured by Petitioner that incorporated term "San Dimas" and might possibly pass the test for what constitutes a trademark (as defined by U.S.C. §1127 and the TMEP §901.01, §901.02, and §904) was the 25th Anniversary Charvel, a guitar which was first displayed at the 2003 Summer NAMM Show in Nashville, TN. Registrant does not know for certain where this item was manufactured, but believes it was built at Petitioner's manufacturing plant in either Corona, California or Ontario, California.

27. Identify all employees, consultants, or individuals related to or involved with Prins' marketing, sale, or offering for sale of guitars sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

Answer: Registrant objects to this request because it is not likely to lead to evidence in support any pleadings in Petitioner's Petition For Cancellation. Without waiving this objection, Registrant states that no other employee, consultant or individual is involved in the sale and marketing of guitars sold in connection SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY trademarked products.

28. Describe Prins' entire employment history, including any and all companies that Prins has been employed by, the positions held at those companies, and the dates of such employment.

Answer: Registrant objects to Petitioner's request for Registrant's employment history as this information it is outside the scope of Petitioner's pleadings and not likely to lead to evidence in support of any pleading made in Petitioner's Petition For Cancellation.

29. Identify all individuals involved in the development of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

Answer: Registrant objects to this request because it is not likely to lead to evidence to support any pleading made by Petitioner in its Petition For Cancellation. Without waiving this objection, Registrant states that he alone created the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY.

30. Identify and describe Prins' first use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

Answer: Registrant objects to this request as it seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive. Registrant directs Petitioner to the USPTO website as a likely source for this information (see registration no. 2,772,766).

31. Identify each time that Prins purchased a Jackson/Charvel guitar from the custom shop, including the date and model number of the guitar purchased.

Answer: Registrant objects to this request because it is not likely to lead to evidence to support any pleadings in Petitioner's Petition For Cancellation. Furthermore, Registrant objects to this request as it seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive.

32. Provide the name, address, and telephone number of all individuals preparing, assisting in the preparation of, or providing information in response to Jackson/Charvel's Interrogatory Requests, identifying the interrogatory or interrogatories for which the assistance or information was provided and the specific information or assistance provided.

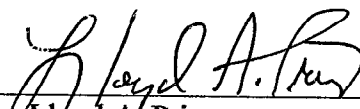
Answer: Registrant states that each response was prepared without the assistance of any other individual.

VERIFICATION OF INTERROGATORY ANSWERS

I, Lloyd A. Prins, Registrant in the above captioned proceeding hereby declare
that I have answered to the best of my knowledge, information and belief,
PETITIONER'S INTERROGATORY REQUESTS TO RESPONDENT and that the
facts stated herein are true and correct.

Dated: December 6, 2004

By: _____


Lloyd A. Prins

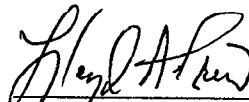
Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, CA 91208

CERTIFICATE OF SERVICE

I, Lloyd A. Prins, hereby certify that I have served REGISTRANT'S RESPONSE
TO PETITIONER'S INTERROGATORY REQUESTS TO RESPONDENT upon:

Mr. Salvador K. Karottki
Goldberg Kohn
55 East Monroe Street
Suite 3700
Chicago, IL 60603-5802

via FedEx Overnight, article number 839889193075. This item was
deposited with sufficient postage December 6, 2004.


Lloyd A. Prins

12/6/2004
Date

EXHIBIT E

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of
Trademark Registration No. 2,772,766
For the Mark SAN DIMAS GUITARS THE
CALIFORNIA GUITAR COMPANY
Registration Date: October 7, 2003

RECEIVED

DEC 07 2004

JACKSON/CHARVEL MANUFACTURING,
INC.

Cancellation No. 92042614

Petitioner,

v.

PRINS, LLOYD A.,
Registrant

To: Salvador K. Karottki
Goldberg, Kohn
55 East Monroe Street, Suite 3700
Chicago, IL 60603

**REGISTRANT'S RESPONSE TO
PETITIONER'S REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and the Trademark Rule 2.119(c), Registrant Lloyd A. Prins hereby answers Petitioner's Request For Production Of Documents And Things.

GENERAL OBJECTION

Registrant objects to the term "doing business as" as used in **Petitioner's Definitions And Instructions** as this term is vague, ambiguous and not likely to lead to admissible evidence in support of Petitioner's pleadings in its Petition for Cancellation.

Registrant's answers to these interrogatories are based on information available to Registrant at the time of completion and Registrant reserves the right to revise, correct or

supplement its responses and/or objections following the discovery or development of additional information.

INDIVIDUAL RESPONSES

1. All documents relating or referring to Jackson/Charvel and its SAN DIMAS mark.

RESPONSE: Registrant states that he has no such documents.

2. All documents relating or referring to Prins' adoption of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Registrant also objects to this request as it seeks documents that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive. Registrant directs Petitioner to the USPTO website as a likely source for this information (see registration no. 2,772,766). Without waiving this objection, Registrant states that no other documents exist.

3. All documents relating to any mark search performed at any time by Prins.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant states that he has no such documents.

4. All documents that evidence or reflect Prins' use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Registrant also objects that this request seeks information that is of a confidential and competitively sensitive nature. Without waiving this objection, Registrant will produce documents that are not confidential or of a sensitive nature.

(See Enclosures Nos. San Dimas 001 through 003)

5. All documents relating to any other marks that Prins contemplated using in connection with his guitars other than the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant states that he has no such documents.

6. All documents relating or referring to or consisting of advertisements for Prins' guitar products sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Registrant also objects that this request seeks information that is of a confidential and competitively sensitive nature. Without waiving this objection, Registrant will produce documents that are not confidential or of a sensitive nature.

(See Enclosure No. San Dimas 003)

7. All documents relating or referring to the mark SAN DIMAS.

RESPONSE: Registrant states that he has no such documents.

8. All documents relating to this Cancellation Proceeding or any advice received from others concerning this Cancellation Proceeding.

RESPONSE: Registrant states that he has no such documents.

9. All correspondence and documents concerning any communications with other individuals concerning Jackson/Charvel's SAN DIMAS mark or this Cancellation Proceeding.

RESPONSE: Registrant states that he has no such documents.

10. All cases, materials, research, or other documents that Prins has collected in order to prepare for this Cancellation since June 13, 2003.

RESPONSE: Registrant objects to this request as it seeks to discover information that is protected by work-product immunity.

11. All documents relating or referring to or constituting any evidence of actual confusion, alleged or claimed confusion, or the appearance of confusion regarding Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand products and Jackson/Charvel's SAN DIMAS brand products or any other product.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant states that he has no such documents.

12. All documents constituting or referring or relating to your communications with third parties regarding your selection, advertising, promotion, naming and/or use of the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant states that he has no such documents.

13. All documents referring or relating to the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Registrant also objects that this request seeks information that is of a confidential and competitively sensitive nature. Without waiving this objection, Registrant will produce these documents under the protection of a protective order.

14. Statements, signed or unsigned, from any person having or purporting to have knowledge or information concerning the subject matter of this Cancellation Proceeding.

RESPONSE: Registrant states that the only such documents are those which have been filed with the TTAB in response to this proceeding. Accordingly, these documents are already in the possession of Petitioner.

15. All documents that refer or relate to any communication received by you that your use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark in any form or style, causes confusion, is likely to cause confusion, or dilutes any mark.

RESPONSE: Registrant states that the only such documents are those produced by Mark VanVleet, General Counsel for Petitioner. Accordingly, these documents are already in the possession of Petitioner.

16. All documents used in connection with Prins' answers to Jackson/Charvel's Interrogatory Requests.

RESPONSE: Registrant states that the following documents are available to Petitioner, which are likely already in Petitioner's possession:

- a) Mark VanVleet's June 13, 2003 letter to Prins

- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents provided by Petitioner in response to Registrant's discovery requests.

17. All documents that Prins has identified or has been requested to identify in response to Jackson/Charvel's Interrogatory Requests.

RESPONSE: Registrant states that the following documents are available to Petitioner, which are likely already in Petitioner's possession:

- e) Mark VanVleet's June 13, 2003 letter to Prins
- f) Prins July 21, 2003 letter to Mark VanVleet
- g) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- h) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents provided by Petitioner in response to Registrant's discovery requests.

18. All documents that Prins intends to offer as evidence in this Cancellation Proceeding.

RESPONSE: Registrant states that he intends to rely on documents offered into evidence by Petitioner as evidence in this proceeding.

19. All sales receipts, invoices, or documents relating to sales of Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand products.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Registrant also objects that this request seeks information that is of a confidential and competitively sensitive nature. Without waiving this objection, Registrant will produce these documents under the protection of a protective order.

20. All documents relating to Jackson/Charvel's warranty policies.

RESPONSE: Registrant objects to this request as it seeks to discover document that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive.

21. All documents concerning any agreements Prins has or had with Jackson/Charvel.

RESPONSE: Registrant objects to this request as it seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive.

22. All invoices, receipts, and documents relating to Prins' purchase of guitars from the Jackson/Charvel custom shop.

RESPONSE: Registrant objects to this request as it seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive.

23. All invoices, receipts, and documents relating to Prins' purchase of SAN DIMAS brand guitars from Jackson/Charvel.

RESPONSE: Registrant states that he has no such documents.

24. All invoices, receipts, and documents relating to Prins' purchase of guitars containing SAN DIMAS brand necks from Jackson/Charvel.

RESPONSE: Registrant states that he has no such documents.

25. All documents referring or relating to communications with Jackson/Charvel concerning the SAN DIMAS mark.

RESPONSE: Registrant states that the only such documents are correspondences produced by Mark VanVleet, General Counsel for Petitioner, and Registrant's reply to those correspondences. Accordingly, these documents are already in the possession of Petitioner.

26. All documents relating to Prins' First Affirmative Defense or the subject matter of such Affirmative Defense.

RESPONSE: Registrant objects to this request as it seeks to discover information that is protected by work-product immunity and/or other applicable privilege or doctrine. Without waiving this objection, Registrant states that he has no such documents.

27. All documents relating to Prins' Second Affirmative Defense or the subject matter of such Affirmative Defense.

RESPONSE: Registrant objects to this request as it seeks to discover information that is protected by work-product immunity and/or other applicable privilege or doctrine. Without waiving this objection, Registrant states that he has no such documents.

28. All documents relating to Prins' Third Affirmative Defense or the subject matter of such Affirmative Defense

RESPONSE: Registrant objects to this request as it seeks to discover information that is protected by work-product immunity and/or other applicable privilege or doctrine. Without waiving this objection, Registrant states that he has no such documents.

29. All documents relating to Prins' Fourth Affirmative Defense or the subject matter of such Affirmative Defense

1. **RESPONSE:** Registrant objects to this request as it seeks to discover information that is protected by work-product immunity and/or other applicable privilege or doctrine. Without waiving this objection, Registrant states that the following documents are available to Petitioner, which are likely already in Petitioner's possession:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents that are a part of the record in this proceeding
- f) All documents provided by Petitioner in response to Registrant's discovery requests.

30. All documents relating to Prins' Fifth Affirmative Defense or the subject matter of such Affirmative Defense

2. **RESPONSE:** Registrant objects to this request as it seeks to discover information that is protected by work-product immunity and/or other applicable privilege or doctrine. Without waiving this objection, Registrant states that the following documents are available to Petitioner, which are likely already in Petitioner's possession:

- a) Mark VanVleet's June 13, 2003 letter to Prins
- b) Prins July 21, 2003 letter to Mark VanVleet
- c) Mark VanVleet's July 24, 2003 letter to Prins (with enclosures)
- d) Prins September 2, 2003 letter to Mark VanVleet
- e) All documents provided by Petitioner in response to Registrant's discovery requests.

31. All documents relating to Prins' choice or use of font for the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark logo.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Registrant also objects that this request seeks information that is of a confidential and competitively sensitive nature. Without waiving this objection, Registrant will produce these documents under the protection of a protective order.

32. All documents relating to Prins' first use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Registrant also objects that this request seeks information that is of a confidential and competitively sensitive nature. Without waiving this objection, Registrant will produce these documents under the protection of a protective order.

33. All advertisements, posters, or point-of-sale displays relating to Jackson/Charvel's SAN DIMAS brand guitars.

RESPONSE: Registrant states that he has no such documents.

34. All articles, including all newspaper and magazine articles, referencing Jackson/Charvel's SAN DIMAS mark of SAN DIMAS brand guitars.

RESPONSE: Registrant states that he has no such documents.

35. All articles, including all newspaper and magazine articles, referencing Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark of SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand guitars.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant states that he has no such documents.

36. Any consumer or market surveys or documents relating to such surveys relating to the SAN DIMAS and SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY marks or the SAN DIMAS and SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand products.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant states that he has no such documents.

37. All documents received from the United States Patent and Trademark Office and documents sent to the United States Patent and Trademark Office relating to the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE: Registrant objects to this request as it seeks to discover documents that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive. Registrant directs Petitioner to the USPTO website as a likely source for this information (see registration no. 2,772,766).

38. All documents relating to or consisting of any communication concerning obtaining registration of or registration of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Registrant also objects to this request as it seeks to discover documents that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive. Registrant directs Petitioner to the USPTO website as a likely source for this information (see registration no. 2,772,766). Without waiving this objection, Registrant states that no other documents exist.

39. An example of a SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand guitar.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant will provide an example of a San Dimas Guitar The California Guitar Company guitar. (See Enclosure No. San Dimas 002)

40. All advertisements or mock-ups for advertisements for Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand guitars.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant will provide all advertisements for a San Dimas Guitar The California Guitar Company guitar. Registrant states that no mock-ups exist. (See Enclosure Nos. 003 and 004)

41. All documents relating to communications with any other individuals, including PR agencies or marketing firms or consultants, concerning the marketing of SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY brand guitars.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant states that he has no such documents.

42. Any opinions concerning whether Prins can or cannot use the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark or concerning whether Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to be confused with Jackson/Charvel's SAN DIMAS mark.

RESPONSE: Registrant objects that this request is irrelevant to the claims and defenses of this proceeding. Without waiving this objection, Registrant states that he has no such documents.

43. All documents that Prins believes support his positions in this Cancellation Proceeding.

RESPONSE: Registrant states that he intends to rely on documents entered into evidence by Petitioner as evidence in this proceeding.

Dated: December 6, 2004

By: _____


Lloyd A. Prins

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, CA 91208

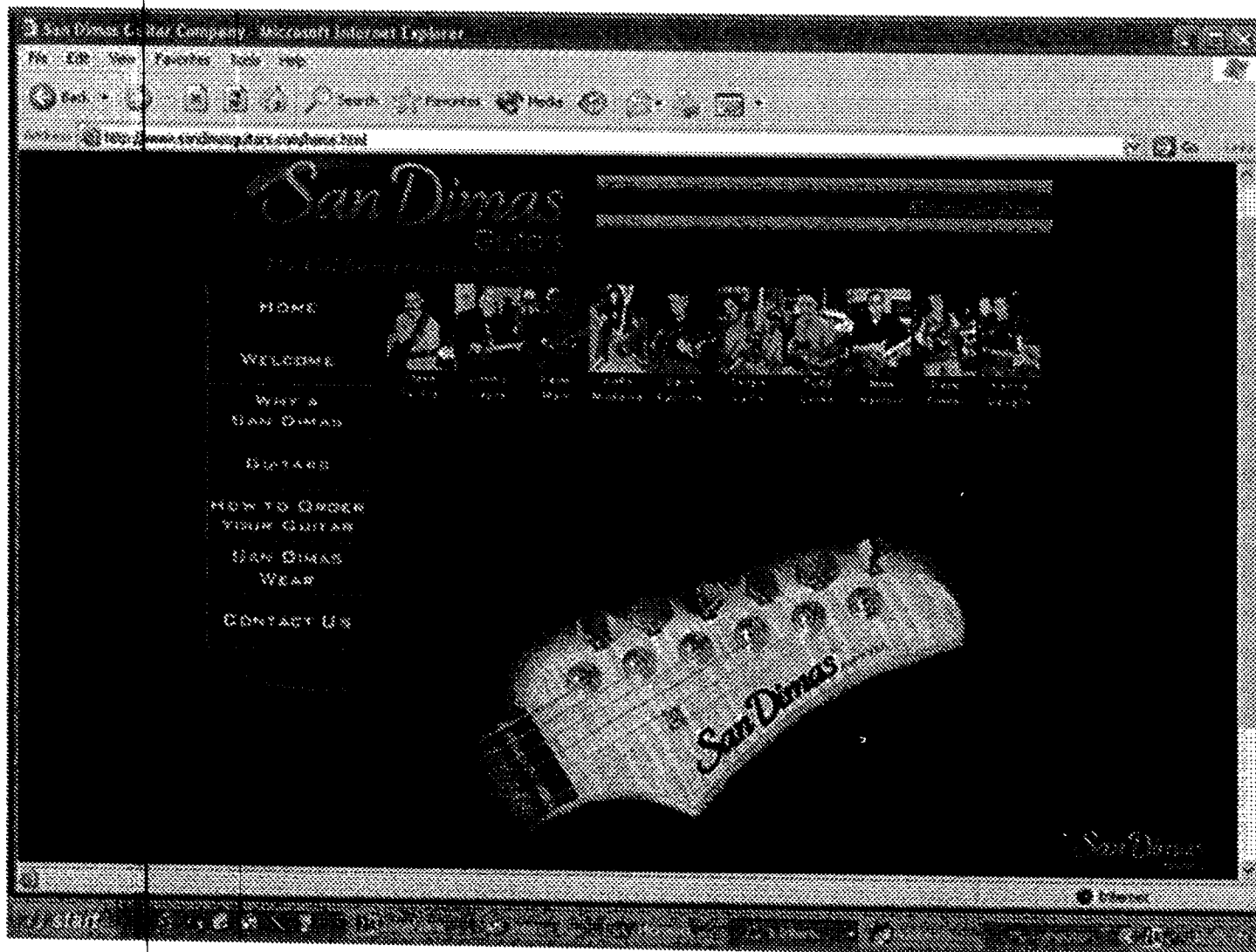
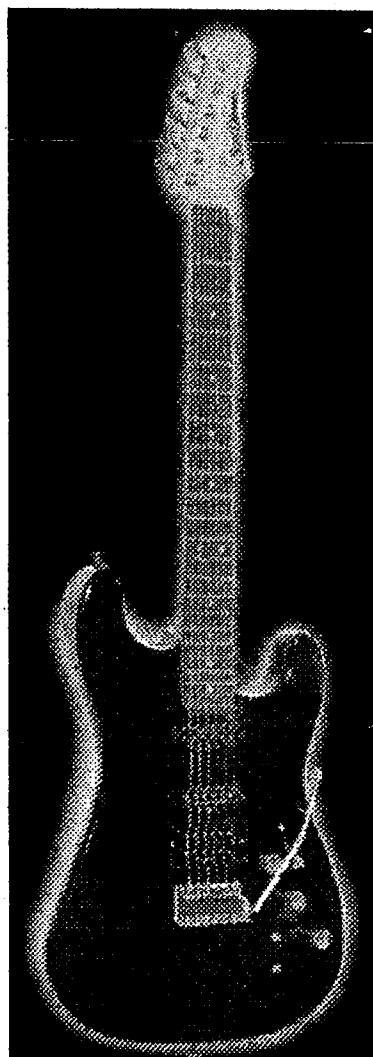
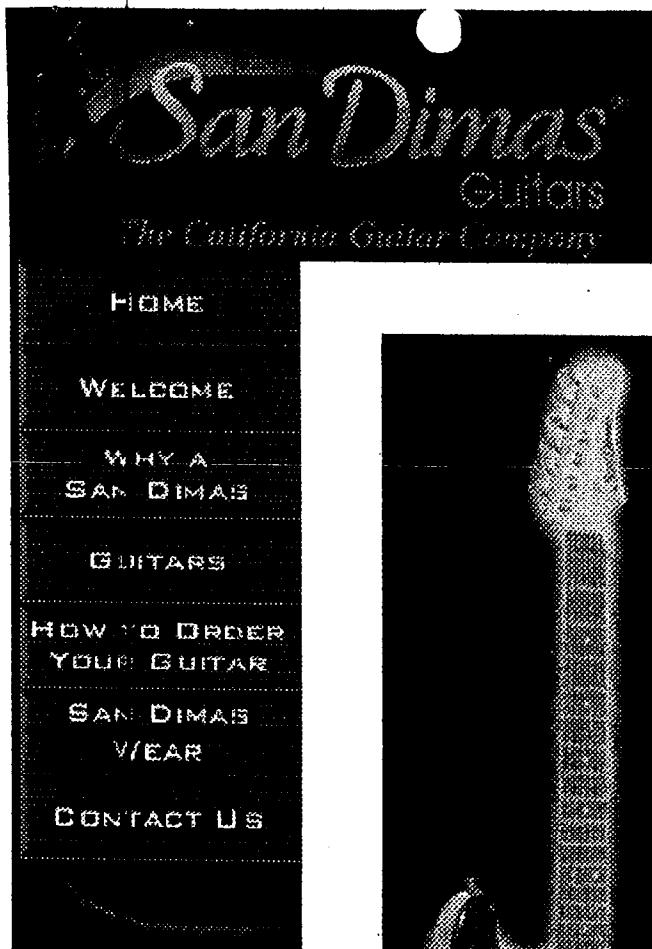


Image of the San Dimas Guitar Company website.

San Dimas 001



Artist Model
Steve Sechler SS1

Guitar List

Construction

Bolt-on Neck
25-1/2" Scale
Alder Body
1/4" Figured Maple Top (Quilt or Flame)
3 piece Neck with Jumbo 6100 Frets
Rosewood fretboard
White Dots Inlays

Pickups

Seymour Duncan StagMag Bridge
Seymour Duncan Classic Stack Middle
Seymour Duncan Little '59 Neck

Acoustic

GraphTech Piezo Saddles

Electronics/Controls

9v Active Preamp
Vol./Tone/Acoustic Vol.
5-way Blade Selector
MicroSwitch Hum Slitter
MicroSwitch Mag/Acoustic/Both
Intuitive Stereo/Mono Output Jack

Parts

Nut: GraphTech Trem Nut
Hardware: Gold
Bridge: Solid Brass Vintage Tremolo
Tuners: Sperzel Locking
Dunlop Dual Design Strap Locks
G&G Tweed, Orange-lined Custom Case

Finishes

Cherry (shown) - Cancun - Honey - Gloss
Natural

Price: US\$ 1,895.00

San Dimas 002

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The California Guitar Company



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 ACOUSTIC ENERGY SUSTAINER
 NO INSTALLATION NEEDED
 Feedback driver quickly clamps
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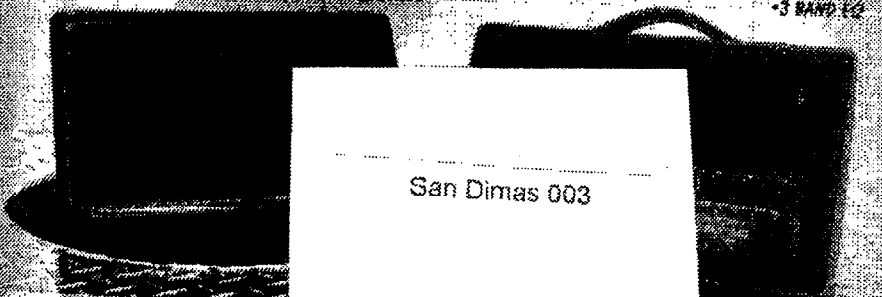
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 on a keyboard, or use as a floor wedge. Reduces stage clutter and stage volume by bringing the
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The Hot Spot is targeted at the vocal frequencies, delivering the range you need to hear.

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Tienen Más
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CERTIFICATE OF SERVICE

I, Lloyd A. Prins, hereby certify that I hve served REGISTRANT'S RESPONSE
TO PETITIONER'S REQUEST FOR DOCUMENTS AND THINGS upon

Mr. Saldivar K. Karottki
Goldberg Kohn
55 East Monroe Street
Suite 3700
Chicago, IL 60603-5802

Via FedEx Overnight, article # 839889193075. This item was deposited with sufficient
postage on December 6, 2004.

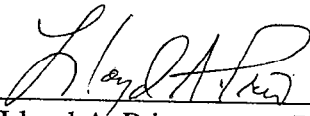

Lloyd A. Prins 12/6/2004
Date

EXHIBIT F

RECEIVED

DEC 07 2004

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of
Trademark Registration No. 2,772,766
For the Mark SAN DIMAS GUITARS THE
CALIFORNIA GUITAR COMPANY
Registration Date: October 7, 2003

JACKSON/CHARVEL MANUFACTURING,
INC.,

Cancellation No. 92042614

Petitioner,

v.

PRINS, LLOYD A.,

Registrant

To: Salvador K. Karottki
Goldberg, Kohn
55 East Monroe Street, Suite 3700
Chicago, IL 60603

REGISTRANT'S RESPONSE TO PETITIONER'S REQUEST FOR ADMISSIONS

Pursuant to Rule 36 of the Federal Rules of Civil Procedure and the Trademark Rule 2.119(c), Registrant Lloyd A. Prins hereby answers Petitioner's Requests For Admissions To Respondent.

GENERAL OBJECTION

Registrant objects to the term "doing business as" as used in **Petitioner's Definitions And Instructions** as this term is vague, ambiguous and not likely to lead to admissible evidence in support of Petitioner's pleadings in its Petition for Cancellation. Additionally, Registrant objects to Petitioner's instruction #7 in which Petitioner states: "If you fail to admit the genuineness of any document or the truth of any matter requested, and the requesting party proves the genuineness of the document or the truth

of the matter, the requesting party shall be entitled to recover the reasonable expenses incurred in making that proof, including reasonable attorneys' fees." Such a statement is neither an instruction nor a definition, is mean-spirited, and merely sets a tone of suspicion and distrust.

INDIVIDUAL RESPONSES

1. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars as early as 1993.

Answer: Denied.

2. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1994.

Answer: Denied.

3. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1995.

Answer: Denied.

4. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1996.

Answer: Denied.

5. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1997.

Answer: Denied.

6. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1998.

Answer: Denied.

7. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 1999.

Answer: Denied.

8. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2000.

Answer: Denied.

9. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2001.

Answer: Denied.

10. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2002.

Answer: Denied.

11. Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2003.

Answer: Denied.

12. Jackson/Charvel has continuously used the SAN DIMAS mark in connection with the sale of guitars from 1993 to present.

Answer: Denied.

13. Jackson/Charvel has sold in the United States tens to hundreds of thousands of dollars worth of electric guitar products using the SAN DIMAS mark.

Answer: Denied.

14. Jackson/Charvel's SAN DIMAS mark has acquired distinctiveness amongst consumers of guitars.

Answer: Denied.

15. Based on Jackson/Charvel's use and promotion of SAN DIMAS mark with respect to electric guitars, the SAN DIMAS mark has acquired goodwill and public recognition among relevant consumers, the industry, and the purchasing public.

Answer: Denied.

16. Jackson/Charvel has not authorized Prins to incorporate the SAN DIMAS mark into any of Prins' marks.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has no rights to a San Dimas mark that entitles Jackson/Charvel to grant such an authorization.

17. Prins' SAN DIMAS logo mark, pictured below, was substantially copied from a Jackson/Charvel SAN DIMAS logo.

Answer: Denied.

18. Prins was aware of Jackson/Charvel's SAN DIMAS mark when he design his SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark logo.

Answer: Registrant objects to this request, as it is vague, ambiguous and otherwise nonsensical and not reasonably capable of discernment. Denied.

19. When Jackson/Charvel was selling SAN DIMAS brand guitars, the SAN DIMAS mark had obtained acquired distinctiveness.

Answer: Denied.

20. From 1997 to 2002, purchasers of electric guitars associated the SAN DIMAS mark with Jackson/Charvel.

Answer: Denied.

21. Jackson/Charvel has not authorized Prins to use the SAN DIMAS mark.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has no rights to a San Dimas mark that entitles Jackson/Charvel to grant such an authorization.

22. Jackson/Charvel has not authorized Prins to use the SAN DIMAS mark in connection with Prins' guitar products.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has no rights to a San Dimas mark that entitles Jackson/Charvel to grant such an authorization.

23. Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to cause confusion, or to cause mistake, or to deceive consumers with respect to Jackson/Charvel's SAN DIMAS mark.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has not established use of a San Dimas trademark.

24. The continued registration of Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark will cause injury and damage to Jackson/Charvel.

Answer: Denied.

25. Jackson/Charvel used its SAN DIMAS mark prior to Prins' use of any mark incorporating the terms "SAN DIMAS."

Answer: Denied.

26. Jackson/Charvel used its SAN DIMAS mark in connection with the sale of electric guitars.

Answer: Denied.

27. Jackson/Charvel used its SAN DIMAS mark in point-of-sale displays associated with its SAN DIMAS brand electric guitars.

Answer: Denied.

28. Prins has purchased one or more SAN DIMAS brand guitars from Jackson/Charvel.

Answer: Denied.

29. Jackson/Charvel provides warranty services for its SAN DIMAS brand guitars.

Answer: Denied.

30. The SAN DIMAS mark is associated in the guitar industry with Jackson/Charvel.

Answer: Denied.

31. Prins owns one or more SAN DIMAS brand guitars made by Jackson/Charvel.

Answer: Denied.

32. Prins has had access to Jackson/Charvel's advertising of its SAN DIMAS brand electric guitars.

Answer: Denied.

33. Prins purchased a SAN DIMAS guitar in 2002 from Jackson/Charvel.

Answer: Denied.

34. Prins owns guitars with SAN DIMAS brand necks purchased from Jackson/Charvel after 1999.

Answer: Denied.

35. Jackson/Charvel's SAN DIMAS brand guitars were never produced in San Dimas, California.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has not established use of a San Dimas trademark.

36. Jackson/Charvel has continuously used the SAN DIMAS mark since 1995.

Answer: Denied.

37. Prins adopted the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark in order to associate him with Jackson/Charvel.

Answer: Denied.

38. Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to cause confusion with Jackson/Charvel's SAN DIMAS mark.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has not established use of a San Dimas trademark.

39. Jackson/Charvel has protectible trademark rights in the SAN DIMAS mark.

Answer: Denied.

40. The SAN DIMAS mark is distinctive.

Answer: Prins admits that the registered San Dimas mark is distinctive to products manufactured and sold by the San Dimas Guitar Company, a company owned and

operated by Prins. Prins denies that a trademark that includes the term "San Dimas" is distinctive to products manufactured and sold by Jackson/Charvel.

41. The SAN DIMAS mark is strong.

Answer: Prins admits that the registered San Dimas mark is strong as it relates to products manufactured and sold by the San Dimas Guitar Company, a company owned and operated by Prins. Prins denies that a trademark that includes the term "San Dimas" is strong as it relates to products manufactured and sold by Jackson/Charvel.

42. Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is very similar in sight, sound, and meaning to Jackson/Charvel's SAN DIMAS mark

Answer: Denied.

43. Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark contains all of the Jackson/Charvel's SAN DIMAS mark.

Answer: Denied.

44. The dominant portions of Prins' mark and Jackson/Charvel's mark is "SAN DIMAS."

Answer: Denied.

45. The dominant portions of Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark and Jackson/Charvel's SAN DIMAS mark are identical.

Answer: Denied.

46. The goods description for Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is "electric guitars and electric basses."

Answer: Admitted.

47. The goods description for Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is identical to the goods with which Jackson/Charvel uses the SAN DIMAS mark in connection.

Answer: Denied.

48. Prins markets and sells products using the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark to the same consumer market as Jackson/Charvel's guitars.

Answer: Prins objects to this request as the terms "same" and "consumer market" are undefined. Without waiving this objection, Prins denies that the purchasers of Jackson/Charvel guitars are the same purchasers of Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY marked guitars.

49. Prins markets and sells products using the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark through the same trade channels as Jackson/Charvel uses to sell its guitars.

Answer: Prins objects to this request as the terms "same" and "trade channels" are undefined. Without waiving this objection, Prins denies that the methods by which Jackson/Charvel guitars enter the market are the equal to the methods by which Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY marked guitars enter the market.

50. Prior to 1997, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied

51. Prior to 1998, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied.

52. Prior to 1999, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied.

53. Prior to 2000, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied.

54. Prior to 2001, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied.

55. Prior to 2002, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied.

56. Prior to 2003, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied.

57. During 2003, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied.

58. During 2004, Prins was licensed and authorized by Jackson/Charvel to use the SAN DIMAS mark in connection with the sale and distribution of SAN DIMAS brand guitars.

Answer: Denied.

59. Prins knowingly chose a mark containing the terms "SAN DIMAS" even though the SAN DIMAS mark is associated with Jackson/Charvel.

Answer: Denied.

60. The SAN DIMAS mark has secondary meaning among guitar consumers.

Answer: Prins admits that there is a secondary meaning of the San Dimas mark as it applies to products manufactured and sold by Prins' and his San Dimas Guitar Company.

Prins denies that a secondary meaning exists with products manufactured and sold by Jackson/Charvel.

61. Jackson/Charvel builds SAN DIMAS brand guitars in its custom shop.

Answer: Denied.

62. Jackson/Charvel has built and marketed SAN DIMAS brand guitars every year since 1993.

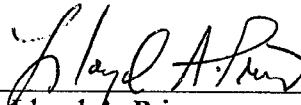
Answer: Denied.

VERIFICATION OF ANSWERS TO ADMISSIONS

Pursuant to Rule 36(a) of the Federal Rules of Civil Procedures, I, Lloyd A. Prins
have answered to the best of my ability, knowledge and information available to me,
PETITIONER'S REQUEST FOR ADMISSIONS.

Dated: December 5, 2004

By: _____


Lloyd A. Prins

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, CA 91208

CERTIFICATE OF SERVICE

I, Lloyd A. Prins, hereby certify that I have served REGISTRANT'S RESPONSE
TO PETITIONER REQUEST FOR ADMISSIONS upon:

Mr. Salvador K. Karottki
Goldberg Kohn
55 East Monroe Street
Suite 3700
Chicago, IL 60603-5802

via FedEx Overnight, article number 839889193075. This item was
deposited with sufficient postage December 6, 2004.

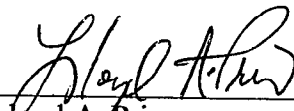

Lloyd A. Prins 12/6/2004
Date

EXHIBIT G

December 29, 2004

sal.karotki@goldbergkohn.com
direct phone: 312.201.3861
direct fax: 312.863.7861

VIA FEDERAL EXPRESS AND ELECTRONIC MAIL

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, California 91208

Re: *Jackson/Charvel Manufacturing, Inc. v. Prins*, Cancellation No. 92042614 – Rule 37 – Failure to Disclose Information

Dear Mr. Prins:

This is a Rule 37 letter. On November 1, 2004, Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel") timely served Interrogatory Requests, Requests for Production, and Requests for Admission upon you. Rather than properly answer or respond to Jackson/Charvel's reasonable discovery requests, in many cases, you either provided evasive and incomplete answers or refused to provide any information at all. For example, you failed to provide any information in response to a third of Jackson/Charvel's Interrogatory Requests; produced only four pages of documents in response to Jackson/Charvel's Requests for Production; and refused to admit or deny certain straightforward and basic Requests for Admission, opting instead to provide complicated, conditional responses. This is unacceptable. We request that you immediately provide good faith responses to Jackson/Charvel's discovery requests, or we will be forced to seek relief from the Trademark Trial and Appeal Board ("TTAB").

In an attempt to resolve this discovery dispute, we provide detailed arguments below for why Jackson/Charvel's discovery requests are relevant and why your objections lack merit. In each case, there can be no dispute that Jackson/Charvel is entitled to a proper response.

Alleged Confidential and/or Proprietary Information

In response to multiple Interrogatory Requests and Requests for Production propounded by Jackson/Charvel, you refused to provide answers or produce documents because they are alleged confidential or proprietary. (See, e.g., Prins' Responses to Jackson/Charvel's Interrogatory Requests, at Nos. 1, 12-4, 20; Prins' Responses to Jackson/Charvel's Requests for Production, at Nos. 4, 6, 13, 19, 31-2.) Without addressing the merits of your claims that the information Jackson/Charvel seeks is confidential or proprietary, we would like to short-circuit any of your concerns by agreeing to a Confidentiality Stipulation and Protective Order ("Confidentiality Stipulation"). As Jackson/Charvel has its own concerns about disclosing confidential information to you, a direct competitor, we believe both parties should be able to agree that signing a Confidentiality Stipulation and promptly disclosing relevant confidential information is the most efficient way to proceed. Toward that end, we have already sent a

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Confidentiality Stipulation to you. Please execute this Confidentiality Stipulation or contact us as soon as possible to discuss it.

Response to Interrogatory Request No. 1

In Interrogatory Request No. 1, Jackson/Charvel requested that you "[e]xplain how Prins adopted or chose the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark for use in connection with electric guitars." You objected to this reasonable request and provided no information. Your first objection states that the request requires you "to disclose proprietary and confidential information." Your second objection states that Interrogatory Request No. 1 is "not likely to lead to admissible evidence."

With respect to your first objection, as noted above, Jackson/Charvel has sent you a Confidentiality Stipulation and would like to enter into such an agreement to avoid any of your concerns. Your second objection has no merit. Information relating to the adoption, selection, and evolution of a registrant's trademark, such as that sought by Jackson/Charvel, is discoverable and relevant. *See, e.g., Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 U.S.P.Q. 207, 208 (T.T.A.B. 1975); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 U.S.P.Q. 471, 473 (T.T.A.B. 1974). Indeed, the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") specifically states as much. *See* TBMP § 414, at 400-68 (2d ed., 1st rev. 2004) ("Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant)."). Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 1.

Response to Interrogatory Request No. 2

In Interrogatory Request No. 2, Jackson/Charvel requested that you "[d]escribe how Prins chose the logo font for the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark, including all materials reviewed in connection with the design of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark logo." You objected to this reasonable request and provided no information, stating that Interrogatory Request No. 2 is "not likely to lead to admissible evidence." As noted above with respect to Interrogatory No. 1, information relating to the adoption, selection, and evolution of a registrant's trademark is discoverable and relevant. Accordingly, your objection has no merit, and Jackson/Charvel is entitled to an answer to Interrogatory No. 2.

Responses to Interrogatory Requests Nos. 3-5

In Interrogatory Requests Nos. 3 through 5, Jackson/Charvel requested that you provide "the entire factual and legal basis" for your first three Affirmative Defenses—laches, waiver, and estoppel, respectively. While you purported to provide and answer to all three Interrogatory Requests, your answers were evasive and incomplete.

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With respect to the factual and legal bases for each respective affirmative defense, your answers were so general as to be useless. When explaining the facts and legal grounds upon which your laches affirmative defense is supposedly based, you stated, "Registrant contends that Petitioner was *negligent* in establishing and maintaining a claim to a trademark that included the term 'San Dimas' in whole or in part." (Emphasis added.) With respect to your supposed waiver affirmative defense, you stated, "Registrant believes that through *Petitioner's actions*, Petitioner waived any and all rights to a trademark that included the term San Dimas in whole or in part." (Emphasis added.) With respect to your supposed estoppel affirmative defense, you stated, "Petitioner has made *several changes* in the conduct and treatment of Petitioner's use of the a [sic] San Dimas mark and that *these changes* were made with the deliberate intent of causing harm to Registrant." (Emphasis added.) Setting aside whether your answers make any sense as legal theories, your answers are so general that we cannot determine any of the factual bases for your defenses. Your responses provide no detail, are wholly inadequate, and must be supplemented.

In your answers to these three Interrogatory Requests, you also state that the factual bases for your arguments are found somewhere in every piece of correspondence between you and Jackson/Charvel's counsel, Mark Van Vleet, as well as in "all documents provided by [Jackson/Charvel] in response to [your] discovery requests." This general response is also inadequate. It is inappropriate for you to designate all correspondence and documents exchanged in connection with this Cancellation Proceeding and generally state that these documents contain the factual bases of your claims without providing any explanation. Jackson/Charvel's Interrogatory Requests are straightforward—they seek only the factual and legal bases for your own affirmative defenses. It is improper of you to attempt to shift the burden onto Jackson/Charvel to sift through every document exchanged in connection with this proceeding to make your arguments for you. If you cannot articulate specific facts and legal arguments supporting your own affirmative defenses, you should withdraw these defenses. If you intend to maintain these defenses, you must adequately supplement you answers to these Interrogatory Requests.

Responses to Interrogatory Requests Nos. 6-7

In Interrogatory Requests Nos. 6 and 7, Jackson/Charvel requested that you provide "the entire factual and legal basis" for your Fourth and Fifth Affirmative Defenses. Like your answers to Interrogatory Requests Nos. 3 through 5, you answered Interrogatory Requests Nos. 6 and 7 with a general citation to all correspondence and documents exchanged in connection with this Cancellation Proceeding. Unlike your answers to Interrogatory Requests Nos. 3 through 5, however, you did not provide *any* factual detail (not even general references to alleged "actions" by Jackson/Charvel) and simply cited to sections of title 15 of the United States Code. As noted above, your answers are so general that we cannot determine any of the factual bases for your Fourth and Fifth Affirmative Defenses. Accordingly, your answers are inadequate and must be supplemented.

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Response to Interrogatory Request No. 10

In Interrogatory Request No. 10, Jackson/Charvel requested that you "[i]dentify all persons with knowledge of the facts, issues, or matters relating to this Cancellation Proceeding." You objected to this reasonable request and provided no information, stating that the request is "vague, ambiguous, and overly broad." Your objection has no merit.

Jackson/Charvel's Interrogatory Request No. 10 seeks to determine what individuals have knowledge of the facts relevant to this proceeding. This request is obviously relevant. The request is also clear and contains no ambiguity or vagueness: What individuals have knowledge of the facts involved in this proceeding? Your objection to the contrary has no merit. Without access to the information sought in this Interrogatory Request, Jackson/Charvel is deprived of the ability to discover information from any individual other than you because Jackson/Charvel does not know these individuals identities. This is unacceptable, and you must answer this Interrogatory Request.

Your objection and failure to answer this Interrogatory Request is particularly disturbing in light of the fact that you propounded a virtually identical request to Jackson/Charvel—a request that Jackson/Charvel answered, providing the names of individuals with knowledge relevant to the proceeding. Your Interrogatory Request No. 3 stated: "Identify each and every person whom Petitioner claims to have knowledge of the facts and claims as set forth in its Petition to Cancel." In light of your similar request, which you certified was consistent with the Federal Rules of Civil Procedure and was not unreasonable, overly broad, or ambiguous, you are obligated to answer Jackson/Charvel's Interrogatory Request No. 10. See TBMP § 408.01, at 400-55 ("[A] party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary.").

Response to Interrogatory Request No. 11

In Interrogatory Request No. 10, Jackson/Charvel requested that you "[i]dentify al[l] persons with knowledge of facts supporting Prins' Affirmative Defenses." You objected to this reasonable request and provided no information, stating that the request is "vague, ambiguous, overly broad, otherwise nonsensical and not reasonably capable of discernment." Your objection has no merit.

As noted above with respect to Interrogatory Request No. 10, Jackson/Charvel is entitled to learn the identities of individuals with knowledge concerning your Affirmative Defenses. You asked similar requests of Jackson/Charvel, and you cannot know contend that such requests are unreasonable. See TBMP § 408.01, at 400-55.

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You apparently contend that Interrogatory Request No. 11 is "nonsensical and not reasonably capable of discernment" because the word "all" in the Interrogatory Request was misspelled "al." While it certainly is possible that typographical errors or misspellings may render a discovery request not reasonably capable of discernment, Interrogatory No. 11 is not such a request. You are well aware of what information Interrogatory Request No. 11 seeks, and your feigned inability to understand the request is disingenuous. We are confident that the TTAB would not agree that you are incapable of discerning the meaning of Interrogatory No. 11. Accordingly, we request that you immediately provide an answer.

Response to Interrogatory Request No. 12

In Interrogatory Request No. 12, Jackson/Charvel requested that you "[i]dentify all individuals whom Prins has communicated with since June 13, 2003, concerning Jackson/Charvel, Jackson/Charvel's SAN DIMAS mark, Prins' use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark, or this Cancellation Proceeding . . . [and] the topic(s) on which Prins communicated with the individual." You objected to this request and provided no information. Your first objection states that the request requires "disclosure of confidential information." Your second objection states that Interrogatory Request No. 12 is "not likely to lead to admissible evidence."

With respect to your first objection, as noted above, Jackson/Charvel has sent you a Confidentiality Stipulation and would like to enter into such an agreement to avoid any of your concerns. Your second objection has no merit. Jackson/Charvel is entitled to learn the identities of individuals with whom you have communicated concerning this proceeding in order to discover whether you made any relevant admissions or disclosed relevant information.

You went on to answer Interrogatory Request No. 12 by identifying *en masse* "tens of hundreds of people" without naming any specific individual. Obviously, this answer does not provide any useful information to Jackson/Charvel or a finder of fact. The instructions to Jackson/Charvel's Interrogatory Requests clearly indicated that to "identify" a person you were required to list that person's (1) full name; (2) present or last-known home and business address (including street name and number, city or town, and state) and telephone number; and (3) present or last-known position, business affiliation, and job description. Yet, you did not "identify" any specific individual or individuals.

In order to focus you on the information that Jackson/Charvel is seeking, we will accept an answer that identifies individuals with whom you have spoken or to whom you requested advice concerning Jackson/Charvel's SAN DIMAS trademark, this Cancellation Proceeding, and the trademark dispute between you and Jackson/Charvel since June 13, 2003, including the topic(s) that were discussed. You should be able to identify these individuals, and we request that you supplement your answer to Interrogatory Request No. 12 accordingly.

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Response to Interrogatory Request No. 13

In Interrogatory Request No. 13, Jackson/Charvel requested that you "[i]dentify all sales of electric guitars bearing or made in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark." You objected to this reasonable request and provided no information, refusing even to provide business records in *lieu* of an answer. Your first objection states that the request seeks "confidential and/or proprietary information." Your second objection states that Interrogatory Request No. 13 is "not likely to lead to admissible evidence."

With respect to your first objection, as noted above, Jackson/Charvel has sent you a Confidentiality Stipulation and would like to enter into such an agreement to avoid any of your concerns. Your second objection is not well taken. A registrant's use of its mark in commerce within the United States is relevant to the issue of priority of use and likelihood of confusion. See *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 U.S.P.Q.2d 1609, 1612 (T.T.A.B. 1992). Your sales of SAN DIMAS brand guitars provide direct evidence of your use of the mark in commerce; therefore, such evidence is both discoverable and relevant. Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 13.

Response to Interrogatory Request No. 14

In Interrogatory Request No. 14, Jackson/Charvel requested that you "[i]dentify all methods through which Prins has marketed, sold, or offered for sale electric guitars bearing or sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark." You objected to this reasonable request and provided no information. Your first objection states that the request requires "disclosure [of] information that is of a competitive and confidential nature." Your second objection states that Interrogatory Request No. 14 is "not likely to lead to admissible evidence."

With respect to your first objection, as noted above, Jackson/Charvel has sent you a Confidentiality Stipulation and would like to enter into such an agreement to avoid any of your concerns. Your second objection has no merit. Information concerning the similarity of trade channels used by the parties is one of the factors in the likelihood of confusion analysis (the *DuPont* factors) and is directly relevant to the claims in Jackson/Charvel's Petition for Cancellation. *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). In Interrogatory No. 14, Jackson/Charvel seeks information that is clearly relevant to the likelihood of confusion analysis, which is at the center of every trademark dispute. Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 14.

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Response to Interrogatory Request No. 15

In Interrogatory Request No. 15, Jackson/Charvel requested that you "[i]dentify all the ways, if any, in which Prins performed a trademark search before adopting the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY." You objected to this reasonable request and provided no information. Your first objection states that the request "assumes facts not in evidence." Your second objection states that Interrogatory Request No. 15 is "not likely to lead to admissible evidence." Both of your objections lack merit.

With respect to your first objection, Interrogatory Request No. 15 assumes no facts. This request clearly states "[i]dentify all ways, *if any*," in which Prins performed a trademark search. (Emphasis added.) If you did not perform any trademark search before adopting your SAN DIMAS trademark, Jackson/Charvel is entitled to know this information, and you should be able to clearly state as much. If you did perform a trademark search of any kind, Jackson/Charvel is entitled to learn this information. Indeed, the TBMP states as much. See TBMP § 414, at 400-68 (stating that information concerning search reports is discoverable). Furthermore, if you were aware of Jackson/Charvel's use of the SAN DIMAS mark through any kind of trademark search prior to the adoption of your SAN DIMAS trademark for use on identical goods, this information is relevant and discoverable. See *id.* § 414, at 400-69 (stating that information concerning a party's awareness of others' use of the same or similar marks is discoverable). Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 15.

Response to Interrogatory No. 19

In Interrogatory Request No. 19, Jackson/Charvel requested that you "[i]dentify any and all mark searches or surveys performed by Prins at any time and the dates on which such searches or surveys were performed." You objected to this reasonable request and provided no information. Your first objection states that the request "assumes facts not in evidence." Your second objection states that Interrogatory Request No. 15 is "not likely to lead to admissible evidence." Both of your objections lack merit.

With respect to your first objection, as in the case of Interrogatory Request No. 15, no facts are assumed in the request. If you have not performed any trademark searches or surveys of any kind, you are required to disclose this relevant information. If you did perform such trademark searches or surveys, Jackson/Charvel is entitled to this information.

As with Interrogatory No. 15, addressed above, Jackson/Charvel is entitled to discover information concerning trademark searches that you have performed. In addition, trademark surveys that you have performed concerning the SAN DIMAS mark are also relevant. Such surveys often provide relevant information concerning the nature and extent of actual confusion, see *E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361, as well as information concerning consumer recognition of a mark in the marketplace. This

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information directly impacts the protectability of your trademark and the likelihood of confusion analysis. Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 19.

Responses to Interrogatory Requests Nos. 21 and 23

In Interrogatory Requests Nos. 21 and 23, Jackson/Charvel requested information concerning the dates on which you became aware of Jackson/Charvel's SAN DIMAS mark "in any format whatsoever," as well as your understanding of when and how Jackson/Charvel used "SAN DIMAS." You answered both of these Interrogatory Requests; however, your answers were incomplete.

As noted above, your knowledge of others' use of "SAN DIMAS" is relevant and discoverable. *See* TBMP § 414, at 400-69. Interrogatory Requests Nos. 21 and 23 seek to discover information about your knowledge of Jackson/Charvel's use of "SAN DIMAS." With respect to its Interrogatory Requests, Jackson/Charvel defined the term "Jackson/Charvel" to include "its predecessors-in-interest, such as International Music Company ('IMC') and Akai Musical Instruments Corporation ('Akai')." Your answers to Interrogatory Requests Nos. 21 and 23 do not include any mention of IMC's or Akai's use of "SAN DIMAS," of which we believe you were well aware. Jackson/Charvel is entitled to learn your understanding of when Jackson/Charvel (including its predecessors-in-interest) first used "SAN DIMAS," over what time period such use occurred, and how such use occurred. Not only is this information relevant to discover your understanding of others' use of "SAN DIMAS," as noted above, but this information is relevant because "[w]hether there is evidence of intent to trade on the goodwill of another is a factor to be considered" in the likelihood of confusion analysis. *See J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991). Accordingly, Jackson/Charvel is entitled to complete answers to Interrogatory Requests Nos. 21 and 23.

Response to Interrogatory Request No. 28

In Interrogatory Request No. 28, Jackson/Charvel requested that you "[d]escribe Prins' entire employment history, including any and all companies that Prins has been employed by, the positions held at those companies, and the dates of such employment." You objected to this reasonable request, stating that Interrogatory Request No. 28 is "not likely to lead to admissible evidence," and provided no information. Your objection has no merit.

Your employment history is relevant to this proceeding because it may provide information about your general knowledge of the guitar manufacturing industry and the products sold within that industry. If you were aware of Jackson/Charvel's extensive use of the SAN DIMAS mark prior to your adoption of a SAN DIMAS mark, as we believe anyone associated with the guitar manufacturing industry would be, this information is relevant. Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 28.

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Response to Interrogatory Request No. 30

In Interrogatory Request No. 30, Jackson/Charvel requested that you "[i]dentify and describe Prins' first use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark." Instead of answering the request, you objected, stating that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive." You provided no information except you directed Jackson/Charvel to the U.S. Patent and Trademark ("U.S. PTO") website, citing it as a "likely source of this information."

Information concerning a registrant's first use of a trademark (including the date and name, address, and affiliation of person who purchased a product bearing the mark) is relevant and discoverable. *See, e.g., Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 U.S.P.Q. 495, 496 (T.T.A.B. 1975); TBMP § 414, at 400-68. In fact, this information is crucial with respect to priority issues. Your refusal to answer a request concerning your own first use of your SAN DIMAS mark is shocking. What source of information would be more convenient and less burdensome concerning the facts surrounding your own first use of a SAN DIMAS mark than you? Your referencing of a government agency website in *lieu* of an answer is improper. Jackson/Charvel is entitled to a full and complete answer to Interrogatory Request No. 30.

Response to Interrogatory Request No. 31

In Interrogatory Request No. 31, Jackson/Charvel requested that you "[i]dentify each time that Prins purchased a Jackson/Charvel guitar from the custom shop, including the date and model number of the guitar purchased." You objected to this reasonable request, stating that Interrogatory Request No. 31 is "not likely to lead to admissible evidence," and provided no information. You also objected that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive."

As noted above, your knowledge of Jackson/Charvel's SAN DIMAS products, which were sold in its custom shop, is relevant and discoverable. Furthermore, your knowledge of these issues is relevant to your intent in adopting your SAN DIMAS mark, which is a factor in the likelihood of confusion analysis. *See J&J Snack Foods Corp.*, 932 F.2d at 1462. You are the best and most convenient source of information concerning your own purchases or purchases made on your behalf from the Jackson/Charvel custom shop. Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 31. At a minimum, you should be able to provide business records which reflect any purchases you may have made from the Jackson/Charvel custom shop.

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Responses to Requests for Production Generally

As noted above, you produced only four pages of documents in response to Jackson/Charvel's multiple Requests for Production. You produced no e-mails. We remind you that the definition of "document" contained in Jackson/Charvel's Requests for Production includes electronic documents and e-mails. Jackson/Charvel requests that you provide all responsive electronic documents and e-mails.

Responses to Requests for Production Nos. 4, 6, 13, 19, 31, and 32

In response to each one of these Requests for Production, you refused to provide certain documents because they are allegedly confidential and/or competitively sensitive.¹ As noted above, we sent you a Confidentiality Stipulation and would like to agree to such terms as soon as possible. Once we have reached agreement, we expect that you will promptly produce all documents responsive to these Requests for Production.

Response to Request for Production No. 20

In Request for Production No. 20, Jackson/Charvel requested "all documents relating to Jackson/Charvel's warranty policies." You objected, stating that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive," and refused to provide any documents.

As we have disclosed in discovery responses, on October 25, 2002, Jackson/Charvel purchased specific assets of the Jackson/Charvel Division of Akai. Consequently, Akai (as well as IMC) are predecessors-in-interest of Jackson/Charvel. Jackson/Charvel's Requests for Production specifically define "Jackson/Charvel" as including its predecessors-in-interest, such as Akai and IMC. If you have any documents concerning the warranty policies of Akai or IMC based on your purchase of guitars from those companies, Jackson/Charvel is entitled to discover these documents. You are the best and most convenient source for this information. Accordingly, we request that you produce these documents immediately.

Response to Request for Production No. 21

In Request for Production No. 21, Jackson/Charvel requested "all documents concerning any agreements Prins has or had with Jackson/Charvel." You objected, stating that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive," and refused to provide any documents.

¹ You also objected that each request was "irrelevant." These objections have no merit.

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These documents are relevant as your knowledge of Jackson/Charvel's use of "SAN DIMAS" is relevant, as noted above. Furthermore, agreements between the registrant and an owner of a prior mark, which form the "market interface" between the two, are directly relevant to the likelihood of confusion analysis. *E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361. Therefore, the documents that Jackson/Charvel seeks are discoverable and relevant.

As noted above, Jackson/Charvel's Requests for Production specifically define "Jackson/Charvel" as including its predecessors-in-interest, such as Akai and IMC. If you had any agreements with Akai or IMC, Jackson/Charvel is entitled to discover these documents. You are the best and most convenient source for this information. Accordingly, we request that you produce these documents immediately.

Response to Request for Production No. 22

In Request for Production No. 22, Jackson/Charvel requested "all invoices, receipts, and documents relating to Prins' purchase of guitars from the Jackson/Charvel custom shop." You objected, stating that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive," and refused to provide any documents.

As noted above, your knowledge of Jackson/Charvel's SAN DIMAS products, which were sold in its custom shop, is relevant and discoverable. Furthermore, your knowledge of these issues is relevant to your intent in adopting your SAN DIMAS mark, which is a factor in the likelihood of confusion analysis. *See J&J Snack Foods Corp.*, 932 F.2d at 1462. You are the best and most convenient source of documents concerning your own purchases or purchases made on your behalf from the Jackson/Charvel custom shop. Accordingly, we request that you produce these documents immediately.

Response to Requests for Production Nos. 26-30

In Requests for Production Nos. 26-30, Jackson/Charvel requested documents relating to each one of your Affirmative Defenses. You objected to each request based on the "work-product immunity and/or other applicable privilege or doctrine." You then provided responses; however, it is unclear whether your responses concern only documents that you feel are not subject to some privilege.

Rule 26 of the Federal Rules of Civil Procedure provides that, if an objection is made to a request for production based on a privilege or the work-product immunity, "the party shall make the claim expressly and shall describe the nature of the documents, communications, or things not produced or disclosed in a manner . . . that will enable other parties to assess the applicability of the privilege or protection." Fed. R. Civ. P. 26(b)(5). Tracking the language of Rule 26, Jackson/Charvel stated in its Instruction to its Requests for Production: "If any privilege is claimed with respect to any documents responsive to these requests, state the nature of the privilege claimed, all facts relied upon in support of the claim, identify all

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documents related to the claim and identify all persons having any knowledge of any facts related to the claim." You did not provide any descriptions of the documents (including author, recipient, or document type) when claiming that certain documents were privileged. Therefore, it is impossible for Jackson/Charvel to evaluate whether your claims of "work-product immunity and/or other applicable privilege" have any merit. Jackson/Charvel requests that you immediately provide appropriate descriptions of documents that you claim are subject to a privilege (a standard privilege log is acceptable) or produce the documents in question.

Response to Requests for Production Nos. 37 and 38

In Requests for Production Nos. 37 and 38, Jackson/Charvel requested documents received from and sent to the U.S. PTO concerning your SAN DIMAS mark, as well as all documents relating to communications with any party relating to registration of your SAN DIMAS mark. You objected to both requests, stating that they sought "to discover documents that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive."²

These documents are obviously relevant, as they concern your communications with the U.S. PTO about the protectability of your SAN DIMAS mark. Jackson/Charvel knows that you had such communications with the U.S. PTO. For example, the U.S. PTO website indicates that you received via e-mail a non-final Office Action from the U.S. PTO on June 19, 2003. The U.S. PTO website also indicates that you responded to this Office Action. You have such documents, and Jackson/Charvel is entitled to review those documents.

You are the most convenient and less expensive source for obtaining such documents. While Jackson/Charvel could contract with a third-party service to copy these documents from the U.S. PTO's files, such services are expensive. Given that you likely have these documents in your possession, it is not a significant burden for you to produce them to Jackson/Charvel. Accordingly, we request that you produce these documents immediately.

Request for Admission No. 11

In Request for Admission No. 11, Jackson/Charvel asked you to admit that "Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2003." You denied this request to admit. Yet, in your answer to Interrogatory No. 23, you stated that Jackson/Charvel used the term "SAN DIMAS" in a trademark in 2003. We do not understand how you can affirmatively state that Jackson/Charvel used the mark in 2003 when answering an Interrogatory Request but deny Request for Admission No. 11, which stated the same thing. You should admit Request for Admission No. 11.

² You also objected that Request for Production No. 38 was "irrelevant." This objection has not merit.

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Requests for Admission Nos. 16, 21, and 22

In Requests for Admission Nos. 16, 21, and 22, Jackson/Charvel asked you to admit that Jackson/Charvel has not authorized your use of its SAN DIMAS trademark. You do not properly answer these Requests for Admission pursuant to Rule 36 of the Federal Rules of Civil Procedure. Instead you refuse to answer the request without fairly meeting their substance, by stating: "Prins cannot admit or deny this request as Prins contends that Jackson/Charvel has no rights to a San Dimas mark that entitled Jackson/Charvel to grant such an authorization."

Jackson/Charvel's Requests for Admission do not assume priority of use by any party and do not assume that Jackson/Charvel has a protectable trademark. Indeed, Jackson/Charvel's Requests for Admission define the term "mark" to include "trademarks, service marks, trade names, or any word or symbol utilized in connection with business activities." Requests for Admission Nos. 16, 21, and 22 simply ask that you admit that Jackson/Charvel has not authorized your use of the term "SAN DIMAS," separate and distinct from whether authorization is necessary or not. You know this is true, and you should admit Requests for Admission Nos. 16, 21, and 22.

Request for Admission No. 38

In Request for Admission No. 38, Jackson/Charvel asked you to admit that "Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to cause confusion with Jackson/Charvel's SAN DIMAS mark." This Request for Admission is straightforward and, if admitted, would simplify this proceeding greatly. Rather than admitting or denying this Request for Admission, you evasively state, "Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has not established use of a San Dimas trademark." Your response is disingenuous and conflicts with your own admissions in your answers to Jackson/Charvel's Interrogatory Requests.

As noted above, Jackson/Charvel defined the term "mark" to include "trademarks, service marks, trade names, or any word or symbol utilized in connection with business activities." Therefore, Request for Admission No. 38 does not imply that Jackson/Charvel has protectable rights in any mark nor does it imply priority of use. Rather, Request for Admission No. 38 relates solely to the issue of likelihood of confusion.

In your answer to Interrogatory No. 17, you affirmatively state that there is a likelihood of confusion between the parties' respective marks. Specifically, you state, "Registrant contends that Petitioner's *continued use* of the term 'San Dimas' in any form *will cause mistakes and confusion* . . . with respect to products manufactured and sold by Registrant and his San Dimas Guitar Company" (Emphasis added.) Given your affirmative statement that a likelihood of confusion exists, your refusal to answer Request for Admission No. 38 is in bad faith.

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This proceeding would be significantly simplified if you admit Request for Admission No. 38. Both parties would be able to focus their attention and resources on contested issues concerning priority and protectability if you truthfully answer Jackson/Charvel's request. You should admit Request for Admission No. 38, and any failure to do so is in bad faith.

Summary

As the foregoing demonstrates, in many respects, your responses to Jackson/Charvel's discovery requests are wholly inadequate or evasive. In many cases, you refused to respond with any information. Jackson/Charvel propounded reasonable and relevant discovery requests upon you and is entitled to responsive answers and documents. We request that you respond immediately. Given the limited amount of information you have provided to Jackson/Charvel during discovery, we need to address this matter without delay so that we can adequately prepare for trial.

I am available to discuss any of the foregoing with you via e-mail or telephone this week, and I request that you call me today or tomorrow to speak about these issues. If we do not hear from you or you refuse to respond to our reasonable requests for information, we will seek relief from the TTAB. While we may be forced to compel proper responses to Jackson/Charvel's discovery requests, we will continue to attempt to work with you to informally address Jackson/Charvel's concerns.

Very truly yours,

A handwritten signature in black ink, appearing to read "Salvador K. Karottki", written in a cursive style.


Salvador K. Karottki

cc: Oscar L. Alcantara

CERTIFICATE OF SERVICE

Salvador K. Karottki, an attorney, certifies that on December 31, 2004, he caused a copy of Jackson/Charvel Manufacturing, Inc.'s **Motion to Compel and to Test Sufficiency of Response to Admission Requests**, along with accompanying **Memorandum in Support**, to be served via U.S. Mail, postage pre-paid, upon:

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, California 91208



Salvador K. Karottki

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)	
Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING,)	Cancellation No. 92042614
INC.,)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A.,)	
Registrant-Respondent.)	

**MEMORANDUM IN SUPPORT OF PETITIONER'S MOTION TO COMPEL AND TO
TEST SUFFICIENCY OF RESPONSE TO ADMISSION REQUESTS**

Petitioner Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel") moves the Trademark Trial and Appeal Board (the "Board") (i) to compel Respondent Lloyd A. Prins' ("Prins") to fully and completely answer Jackson/Charvel's Interrogatory Nos. 1-7, 10-15, 19, 21, 23, 28, 30, and 31; (ii) to compel Prins to produce documents in response to Jackson/Charvel's Requests for Production Nos. 21-22, 26-30, 37, and 38; and (iii) to deem admitted Jackson/Charvel's Admission Requests Nos. 11, 16, 21, 22, and 38.

Rather than properly answer or respond to Jackson/Charvel's reasonable discovery requests, in many cases, Prins either provided evasive and incomplete answers or refused to provide any information at all. For example, Prins failed to provide any information in response to a third of Jackson/Charvel's Interrogatories; produced only four pages of documents in response to Jackson/Charvel's Requests for Production; and refused to admit or deny certain straightforward and basic Requests for Admission, opting instead to provide evasive, nonresponsive or qualifying answers. These inadequate responses to Jackson/Charvel's

discovery requests form the basis of Jackson/Charvel's Motion to Compel and to Test Sufficiency of Response to Admission Request (the "Motion").

I. PRINS' OBJECTIONS BASED ON CONFIDENTIALITY

In response to multiple Interrogatories and Requests for Production propounded by Jackson/Charvel, Prins refused to provide answers or produce documents because they are allegedly confidential or proprietary. (*See, e.g.*, Prins' Responses to Jackson/Charvel's Interrogatories, attached as Exhibit D to the Motion, at Nos. 1, 12-14, 20; Prins' Responses to Jackson/Charvel's Requests for Production, attached as Exhibit E to the Motion, at Nos. 4, 6, 13, 19, 31-32.) Both parties have agreed in principle to the need for a Confidentiality Stipulation and Protective Order ("Confidentiality Stipulation") and are negotiating language for such Confidentiality Stipulation. Jackson/Charvel believes that the parties should be able to reach agreement on a Confidentiality Stipulation that then can be submitted to the Board. Therefore, while Prins has not produced any information concerning Jackson/Charvel's Interrogatories Nos. 1, 12-14, and 20 and Requests for Production Nos. 4, 6, 13, 19, and 31-32, Jackson/Charvel does not move in this Motion to compel responses based on Prins' objections concerning confidentiality. However, Jackson/Charvel expressly preserves its rights to move to compel responses and/or production of documents in response to these discovery requests if Prins ultimately refuses to produce documents after a Confidentiality Stipulation is signed or refuses to sign a Confidentiality Stipulation.

II. PRINS' FAILURE TO ANSWER JACKSON/CHARVEL'S INTERROGATORIES

A. Prins' Response to Interrogatory No. 1

In Interrogatory No. 1, Jackson/Charvel requested that Prins "[e]xplain how he adopted or chose the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark for use in connection with electric guitars." (Exhibit D to Motion at p. 2.) Prins objected to this

reasonable request and provided no information. Prins objection states that Interrogatory No. 1 is "not likely to lead to admissible evidence."¹ (*Id.*) This objection is baseless.

Information relating to the adoption, selection, and evolution of a registrant's trademark, such as that sought by Jackson/Charvel, is discoverable and relevant. *See, e.g., Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 U.S.P.Q. 207, 208 (T.T.A.B. 1975); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 U.S.P.Q. 471, 473 (T.T.A.B. 1974). Indeed, the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") specifically states as much. *See* TBMP § 414, at 400-68 (2d ed., 1st rev. 2004) ("Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant)."). Accordingly, Jackson/Charvel is entitled to a full and complete answer to Interrogatory No. 1, and the Board should compel Prins to provide such an answer.

B. Prins' Response to Interrogatory No. 2

In Interrogatory No. 2, Jackson/Charvel requested that Prins "[d]escribe how Prins chose the logo font for the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark, including all materials reviewed in connection with the design of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark logo." (Exhibit D to Motion at p. 2.) Prins objected to this reasonable request and provided no information, stating that Interrogatory No. 2 is "not likely to lead to admissible evidence." (*Id.*) As noted above with respect to Interrogatory No. 1, information relating to the adoption, selection, and evolution of a registrant's trademark is discoverable and relevant. *See, e.g., Goodyear Tire & Rubber Co.*, 186 U.S.P.Q. at 208; *Volkswagenwerk Aktiengesellschaft*, 181 U.S.P.Q. at 473. Furthermore, because Prins' logo looks strikingly similar to the SAN DIMAS logo used by Jackson/Charvel,

¹ Prins also objected that the request required him "to disclose proprietary and confidential information," (*id.*); however, as noted above, this objection will not be addressed in this Motion, although Jackson/Charvel preserves its rights.

this information is relevant because "[w]hether there is evidence of intent to trade on the goodwill of another is a factor to be considered" in the likelihood of confusion analysis. *See J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991). Accordingly, Jackson/Charvel is entitled to a full and complete answer to Interrogatory No. 2, and the Board should compel Prins to provide such an answer.

C. Prins' Responses to Interrogatory Nos. 3-5

In Interrogatory Nos. 3 through 5, Jackson/Charvel requested that Prins provide "the entire factual and legal basis" for his first three Affirmative Defenses—laches, waiver, and estoppel, respectively.² (Exhibit D to Motion at pp. 2-5.) While Prins purported to provide an answer to all three Interrogatories, Prins' answers were evasive and incomplete.

With respect to the factual and legal bases for each respective affirmative defense, Prins' answers were so general as to be useless. When explaining the facts and legal grounds upon which Prins' laches affirmative defense is supposedly based, he stated, "Registrant contends that Petitioner was *negligent* in establishing and maintaining a claim to a trademark that included the term 'San Dimas' in whole or in part." (*Id.* at pp. 2-3 (emphasis added).) With respect to Prins' purported waiver affirmative defense, he stated, "Registrant believes that through *Petitioner's actions*, Petitioner waived any and all rights to a trademark that included the term San Dimas in whole or in part." (*Id.* at p. 3 (emphasis added).) With respect to Prins' purported estoppel affirmative defense, he stated, "Petitioner has made *several changes* in the conduct and treatment of Petitioner's use of the a [sic] San Dimas mark and that *these changes* were made with the deliberate intent of causing harm to Registrant." (*Id.* at p. 4 (emphasis added).) Prins' answers are so general that neither Jackson/Charvel nor any finder could determine any of the

² Jackson/Charvel moves to compel only an explanation "of the entire factual and legal basis for" Prins' Affirmative Defenses.

factual bases for Prins' defenses. Without a description of the allegedly "negligent" acts, the alleged "actions," and the alleged "changes" that Jackson/Charvel made, Jackson/Charvel cannot even begin to understand the bases of Prins' Affirmative Defenses.

Furthermore, in Prins' answers to Interrogatory Nos. 3-5, Prins also states that the factual bases for his arguments are found somewhere in every piece of correspondence between him and Jackson/Charvel's counsel, Mark Van Vleet, as well as in "all documents provided by [Jackson/Charvel] in response to [your] discovery requests." (*Id.* at pp. 2-4 (emphasis added).) Prins' general responses are also inadequate. It is inappropriate for Prins to designate all correspondence and documents exchanged in connection with this Cancellation Proceeding and generally state that these documents contain the factual bases of his claims without providing any explanation.

Jackson/Charvel's Interrogatories are straightforward—they seek only the factual and legal bases for Prins' own affirmative defenses. It is improper of Prins to attempt to shift the burden onto Jackson/Charvel to sift through every document exchanged in connection with this proceeding to make Prins' arguments for him. If Prins cannot articulate specific facts and legal arguments supporting his own affirmative defenses, then those affirmative defenses should be stricken. Accordingly, the Board should strike Prins' First, Second, and Third Affirmative Defenses or, in the alternative, require Prins to fully and completely answer Interrogatory Nos. 3 through 5.

D. Prins' Responses to Interrogatory Nos. 6-7

In Interrogatory Nos. 6 and 7, Jackson/Charvel requested that Prins provide "the entire factual and legal basis" for your Fourth and Fifth Affirmative Defenses.³ (Exhibit D to

³ Jackson/Charvel moves to compel only an explanation "of the entire factual and legal basis for" Prins' Affirmative Defenses.

Motion at pp. 4-6.) Like his answers to Interrogatory Nos. 3 through 5, Prins answered Interrogatory Requests Nos. 6 and 7 with a general citation to all correspondence and documents exchanged in connection with this Cancellation Proceeding. (*Id.*) Unlike Prins' answers to Interrogatory Requests Nos. 3 through 5, however, he did not provide *any* factual detail (not even general references to alleged "actions" by Jackson/Charvel) and simply cited to sections of title 15 of the United States Code. (*Id.*) As noted above, Prins' answers are so general that neither Jackson/Charvel nor any finder could determine any of the factual bases for his Fourth and Fifth Affirmative Defenses. If Prins cannot articulate specific facts supporting his own affirmative defenses, then those affirmative defenses should be stricken. Accordingly, the Board should strike Prins' Fourth and Fifth Affirmative Defenses or, in the alternative, require Prins to fully and completely answer Interrogatory Nos. 6 and 7.

E. Prins' Response to Interrogatory No. 10

In Interrogatory Request No. 10, Jackson/Charvel requested that Prins "[i]dentify all persons with knowledge of the facts, issues, or matters relating to this Cancellation Proceeding." (*Id.* at p. 7.) Prins objected to this reasonable request and provided no information, stating that the request is "vague, ambiguous, and overly broad." (*Id.*) Prins' objection has no merit.

Jackson/Charvel's Interrogatory No. 10 seeks to determine what individuals have knowledge of the facts relevant to this proceeding. This request is obviously relevant. The request is also clear and contains no ambiguity or vagueness: What individuals have knowledge of the facts involved in this proceeding? Without access to the information sought in this Interrogatory, Jackson/Charvel is deprived of the ability to discover information from any individual other than Prins because Jackson/Charvel does not know these individuals identities.

Prins' objection and failure to answer this Interrogatory Request is particularly disturbing in light of the fact that he propounded a virtually identical request to Jackson/Charvel—a request that Jackson/Charvel answered, providing the names of individuals with knowledge relevant to the proceeding. Prins' Interrogatory Request No. 3 to Jackson/Charvel stated: "Identify each and every person whom Petitioner claims to have knowledge of the facts and claims as set forth in its Petition to Cancel." (*See* Prins' Interrogatories to Jackson/Charvel, attached hereto as Exhibit 1, at p. 4.) In light of Prins' similar request, which he certified was consistent with the Federal Rules of Civil Procedure and was not unreasonable, overly broad, or ambiguous, Prins is obligated to answer Jackson/Charvel's Interrogatory No. 10. *See* TBMP § 408.01, at 400-55 ("[A] party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary."). Accordingly, Jackson/Charvel is entitled to a full and complete answer to Interrogatory No. 10, and the Board should compel Prins to provide such an answer.

F. Prins' Response to Interrogatory No. 11

In Interrogatory No. 11, Jackson/Charvel requested that Prins "[i]dentify al[l] persons with knowledge of facts supporting Prins' Affirmative Defenses." (Exhibit D to Motion at p. 7.) Prins objected to this reasonable request and provided no information, stating that the request is "vague, ambiguous, overly broad, otherwise nonsensical and not reasonably capable of discernment." (*Id.*)

As noted above with respect to Interrogatory No. 10, Jackson/Charvel is entitled to learn the identities of individuals with knowledge concerning Prins' Affirmative Defenses. Prins asked similar requests of Jackson/Charvel and cannot now contend that such requests are unreasonable. *See* TBMP § 408.01, at 400-55.

Prins apparently contends that Interrogatory No. 11 is "nonsensical and not reasonably capable of discernment" because the word "all" in the Interrogatory was misspelled "al." While it certainly is possible that typographical errors or misspellings may render a discovery request not reasonably capable of discernment, Interrogatory No. 11 is not such a request. Prins is well aware of what information Interrogatory Request No. 11 seeks, and his feigned inability to understand the request is disingenuous. Prins is not incapable of discerning the meaning of Interrogatory No. 11. Accordingly, Jackson/Charvel is entitled to a full and complete answer to Interrogatory No. 11, and the Board should compel Prins to provide such an answer.

G. Prins' Response to Interrogatory No. 12

In Interrogatory No. 12, Jackson/Charvel requested that Prins "[i]dentify all individuals whom Prins has communicated with since June 13, 2003, concerning Jackson/Charvel, Jackson/Charvel's SAN DIMAS mark, Prins' use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark, or this Cancellation Proceeding . . . [and] the topic(s) on which Prins communicated with the individual." (Exhibit D to Motion at p. 7.) Prins objected to this request, stating that Interrogatory No. 12 is "not likely to lead to admissible evidence."⁴ (*Id.*)

Prins then went on to answer Interrogatory No. 12 by identifying *en masse* "tens of hundreds of people" without naming any specific individual. (*See id.* at 8.) This answer does not provide any useful information to Jackson/Charvel or a finder of fact. The instructions to Jackson/Charvel's Interrogatory Requests clearly indicated that to "identify" a person you were required to list that person's (1) full name; (2) present or last-known home and business address

⁴ Prins also objected that the request required "disclosure of confidential information," (*id.* at p. 7); however, as noted above, this objection will not be addressed in this Motion, although Jackson/Charvel preserves its rights.

(including street name and number, city or town, and state) and telephone number; and (3) present or last-known position, business affiliation, and job description. (See Exhibit A to Motion at p. 2.) Yet, Prins did not "identify" any specific individual or individuals.

Jackson/Charvel informed Prins pursuant to Rule 37 that it would accept an answer that identifies individuals with whom he has spoken or to whom he requested advice concerning Jackson/Charvel's SAN DIMAS trademark, this Cancellation Proceeding, and the trademark dispute between Prins and Jackson/Charvel since June 13, 2003, including the topic(s) that were discussed. (See Exhibit G to Motion at 5.) This information is both relevant and is not unduly burdensome. Accordingly, the Board should compel Prins to provide such information to Jackson/Charvel.

H. Prins' Response to Interrogatory No. 13

In Interrogatory No. 13, Jackson/Charvel requested that Prins "[i]dentify all sales of electric guitars bearing or made in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark." (Exhibit D to Motion at p. 8.) Prins objected to this reasonable request and provided no information, refusing even to provide business records in lieu of an answer. Prins objection states that Interrogatory No. 13 is "not likely to lead to admissible evidence."⁵ (*Id.*) Prins objection is not well taken.

A registrant's use of its mark in commerce within the United States is relevant to the issue of priority of use and likelihood of confusion. See *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 U.S.P.Q.2d 1609, 1612 (T.T.A.B. 1992). Prins sales of SAN DIMAS brand guitars provide direct evidence of his use of the mark in commerce; therefore, such evidence is both discoverable and relevant. Accordingly, Jackson/Charvel is entitled to a full

⁵ Prins also objected that the request required him to disclose "confidential and/or proprietary information," (*id.*); however, as noted above, this objection will not be addressed in this Motion, although Jackson/Charvel preserves its rights.

and complete answer to Interrogatory No. 13, and the Board should compel Prins to provide such an answer.

I. Prins' Response to Interrogatory No. 14

In Interrogatory No. 14, Jackson/Charvel requested that Prins "[i]dentify all methods through which Prins has marketed, sold, or offered for sale electric guitars bearing or sold in connection with the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark." (Exhibit D to Motion at p. 8.) Prins objected to this reasonable request and provided no information, stating that Interrogatory No. 14 is "not likely to lead to admissible evidence."⁶ (*Id.*) Prins' objection has no merit.

Information concerning the similarity of trade channels used by the parties is one of the factors in the likelihood of confusion analysis (the *DuPont* factors) and is directly relevant to the claims in Jackson/Charvel's Petition for Cancellation. *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). In Interrogatory No. 14, Jackson/Charvel seeks information that is clearly relevant to the likelihood of confusion analysis, which is at the center of every trademark dispute. Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 14, and the Board should compel Prins to provide such an answer.

J. Prins' Response to Interrogatory No. 15

In Interrogatory No. 15, Jackson/Charvel requested that Prins "[i]dentify all the ways, if any, in which Prins performed a trademark search before adopting the mark SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY." (Exhibit D to Motion at p. 8.) Prins objected to this reasonable request and provided no information. His first objection states

⁶ Prins also objected that the request required "disclosure [of] information that is of a competitive and confidential nature," (*id.*); however, as noted above, this objection will not be addressed in this Motion, although Jackson/Charvel preserves its rights.

that the request "assumes facts not in evidence." (*Id.*) His second objection states that Interrogatory No. 15 is "not likely to lead to admissible evidence." (*Id.*) Both of Prins' objections lack merit.

With respect to Prins' first objection, Interrogatory No. 15 assumes no facts. This request clearly states "[i]dentify all ways, *if any*," in which Prins performed a trademark search. (*Id.* (emphasis added).) If Prins did not perform any trademark search before adopting his SAN DIMAS trademark, Jackson/Charvel is entitled to know this information, and Prins should be able to clearly state as much. If Prins did perform a trademark search of any kind, Jackson/Charvel is entitled to learn this information. Indeed, the TBMP states as much. *See* TBMP § 414, at 400-68 (stating that information concerning search reports is discoverable). Furthermore, if Prins was aware of Jackson/Charvel's use of the SAN DIMAS mark through any kind of trademark search prior to the adoption of his SAN DIMAS trademark for use on identical goods, this information is relevant and discoverable. *See id.* § 414, at 400-69 (stating that information concerning a party's awareness of others' use of the same or similar marks is discoverable). Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 15, and the Board should compel Prins to provide such an answer.

K. Prins' Response to Interrogatory No. 19

In Interrogatory No. 19, Jackson/Charvel requested that Prins "[i]dentify any and all mark searches or surveys performed by Prins at any time and the dates on which such searches or surveys were performed." (Exhibit D to Motion at p. 10.) Prins objected to this reasonable request and provided no information. Prins first objection states that the request "assumes facts not in evidence." (*Id.*) Prins second objection states that Interrogatory No. 15 is "not likely to lead to admissible evidence." (*Id.*) Both of Prins' objections lack merit.

With respect to Prins' first objection, as in the case of Jackson/Charvel's Interrogatory No. 15, no facts are assumed in the request. If Prins did not performed any trademark searches or surveys of any kind, he are required to disclose this relevant information. If Prins did perform such trademark searches or surveys, Jackson/Charvel is entitled to this information.

As with Jackson/Charvel's Interrogatory No. 15, addressed above, Jackson/Charvel is entitled to discover information concerning trademark searches that Prins performed or had performed. In addition, trademark surveys that Prins performed or had performed concerning the SAN DIMAS mark are also relevant. Such surveys often provide relevant information concerning the nature and extent of actual confusion, *see E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361, as well as information concerning consumer recognition of a mark in the marketplace. This information directly impacts the protectability of Prins' trademark and the likelihood of confusion analysis. Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 19, and the Board should compel Prins to provide such an answer.

L. Prins' Responses to Interrogatory Nos. 21 and 23

In Interrogatory Nos. 21 and 23, Jackson/Charvel requested information concerning the dates on which you became aware of Jackson/Charvel's SAN DIMAS mark "in any format whatsoever," as well as Prins' understanding of when and how Jackson/Charvel used "SAN DIMAS." (Exhibit D to Motion at p. 11.) Prins answered both of these Interrogatories; however, his answers were incomplete.

As noted above, Prins' knowledge of others' use of "SAN DIMAS" is relevant and discoverable. *See* TBMP § 414, at 400-69. Interrogatory Nos. 21 and 23 seek to discover information about Prins' knowledge of Jackson/Charvel's use of "SAN DIMAS." With respect to

its Interrogatories, Jackson/Charvel defined the term "Jackson/Charvel" to include "its predecessors-in-interest, such as International Music Company ('IMC') and Akai Musical Instruments Corporation ('Akai')." (Exhibit A to Motion at pp. 1-2.) Prins' answers to Interrogatory Nos. 21 and 23 did not include any mention of IMC's or Akai's use of "SAN DIMAS," of which Jackson/Charvel believes Prins was well aware. Jackson/Charvel is entitled to learn Prins' understanding of when Jackson/Charvel (including its predecessors-in-interest) first used "SAN DIMAS," over what time period such use occurred, and how such use occurred. Not only is this information relevant to discover Prins' understanding of others' use of "SAN DIMAS," as noted above, but this information is relevant because "[w]hether there is evidence of intent to trade on the goodwill of another is a factor to be considered" in the likelihood of confusion analysis. *See J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991). Accordingly, Jackson/Charvel is entitled to full and complete answers to Interrogatory Nos. 21 and 23, and the Board should compel Prins to provide such an answer.

M. Prins' Response to Interrogatory Request No. 28

In Interrogatory No. 28, Jackson/Charvel requested that Prins "[d]escribe Prins' entire employment history, including any and all companies that Prins has been employed by, the positions held at those companies, and the dates of such employment." (Exhibit D to Motion at p. 13.) Prins objected to this reasonable request, stating that Interrogatory No. 28 is "not likely to lead to admissible evidence," and provided no information. (*Id.*) Prins' objection has no merit.

Prins' employment history is relevant to this proceeding because it may provide information about his general knowledge of the guitar manufacturing industry and the products sold within that industry. If Prins was aware of Jackson/Charvel's extensive use of the SAN DIMAS mark prior to his adoption of a SAN DIMAS mark, as Jackson/Charvel believes anyone associated with the guitar manufacturing industry would be, this information is relevant.

Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 28, and the Board should compel Prins to provide such an answer.

N. Prins' Response to Interrogatory No. 30

In Interrogatory No. 30, Jackson/Charvel requested that Prins "[i]dentify and describe Prins' first use of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark." (Exhibit D to Motion at p. 14.) Instead of answering the request, Prins objected, stating that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive." (*Id.*) Prins provided no information except that he directed Jackson/Charvel to the U.S. Patent and Trademark ("U.S. PTO") website, citing it as a "likely source of this information." (*Id.*)

Information concerning a registrant's first use of a trademark (including the date and name, address, and affiliation of person who purchased a product bearing the mark) is relevant and discoverable. *See, e.g., Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 U.S.P.Q. 495, 496 (T.T.A.B. 1975); TBMP § 414, at 400-68. Obviously, this information is crucial with respect to priority issues. Prins' refusal to answer a request concerning his own first use of his SAN DIMAS mark is surprising. What source of information would be more convenient and less burdensome concerning the facts surrounding Prins' own first use of a SAN DIMAS mark than Prins himself? Prins' reference to the U.S. PTO website website in *lieu* of an answer is improper. Jackson/Charvel is entitled to a full and complete answer to Interrogatory No. 30, and the Board should compel Prins to provide such an answer.

O. Prins' Response to Interrogatory No. 31

In Interrogatory No. 31, Jackson/Charvel requested that Prins "[i]dentify each time that Prins purchased a Jackson/Charvel guitar from the custom shop, including the date and model number of the guitar purchased." (Exhibit D to Motion at p. 14.) Prins objected to this

reasonable request, stating that Interrogatory No. 31 is "not likely to lead to admissible evidence," and provided no information. (*Id.*) He also objected that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive." (*Id.*)

As noted above, Prins' knowledge of Jackson/Charvel's SAN DIMAS products, which were sold in its custom shop, is relevant and discoverable. Furthermore, Prins' knowledge of these issues is relevant to his intent in adopting his SAN DIMAS mark, which is a factor in the likelihood of confusion analysis. See *J&J Snack Foods Corp.*, 932 F.2d at 1462. Prins' is the best and most convenient source of information concerning his own purchases or purchases made on his behalf from the Jackson/Charvel custom shop. Accordingly, Jackson/Charvel is entitled to an answer to Interrogatory No. 31. At a minimum, Prins should be able to provide business records that reflect any purchases he may have made from the Jackson/Charvel custom shop. The Board should compel Prins to provide an answer to Interrogatory No. 31.

III. PRINS' FAILURE TO PRODUCE DOCUMENTS IN RESPONSE TO JACKSON/CHARVEL'S DOCUMENT REQUESTS

A. Response to Request for Production No. 21

In Request for Production No. 21, Jackson/Charvel requested "all documents concerning any agreements Prins has or had with Jackson/Charvel." (Exhibit E to Motion at 6.) Prins objected, stating that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive," and refused to provide any documents. (*Id.*)

These documents are relevant because Prins' knowledge of Jackson/Charvel's use of "SAN DIMAS" is relevant, as noted above. Furthermore, agreements between the registrant and an owner of a prior mark, which form the "market interface" between the two, are directly

relevant to the likelihood of confusion analysis. *E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361. Therefore, the documents that Jackson/Charvel seeks are discoverable and relevant.

Furthermore, as noted above, on October 25, 2002, Jackson/Charvel purchased specific assets of the Jackson/Charvel Division of Akai. Consequently, Akai (as well as IMC) are predecessors-in-interest of Jackson/Charvel. Jackson/Charvel's Requests for Production specifically define "Jackson/Charvel" as including its predecessors-in-interest, such as Akai and IMC. (See Exhibit B to Motion at 1-2.) If Prins had any agreements with Akai or IMC, Jackson/Charvel is entitled to discover these documents. Prins is the best and most convenient source for this information. Accordingly, Jackson/Charvel is entitled to review all documents responsive to Request for Production No. 21, and the Board should compel Prins to produce such documents.

B. Prins' Response to Request for Production No. 22

In Request for Production No. 22, Jackson/Charvel requested "all invoices, receipts, and documents relating to Prins' purchase of guitars from the Jackson/Charvel custom shop." (Exhibit E to Motion at p. 6.) Prins objected, stating that the request "seeks information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive," and refused to provide any documents. (*Id.*)

As noted above, Prins' knowledge of Jackson/Charvel's SAN DIMAS products, which were sold in its custom shop, is relevant and discoverable. Furthermore, Prins' knowledge of these issues is relevant to his intent in adopting a SAN DIMAS mark, which is a factor in the likelihood of confusion analysis. See *J&J Snack Foods Corp.*, 932 F.2d at 1462. Prins is the best and most convenient source of documents concerning his own purchases or purchases made on his behalf from the Jackson/Charvel custom shop. Accordingly, Jackson/Charvel is entitled

to review all documents responsive to Request for Production No. 22, and the Board should compel Prins to produce such documents.

C. Prins' Response to Requests for Production Nos. 26-30

In Requests for Production Nos. 26-30, Jackson/Charvel requested documents relating to each one of Prins' Affirmative Defenses. (Exhibit E to Motion at pp. 6-7.) Prins objected to each request based on the "work-product immunity and/or other applicable privilege or doctrine." (*Id.*) Prins then provided responses; however, it is unclear whether his responses concern only documents that he feels are not subject to some privilege.

Rule 26 of the Federal Rules of Civil Procedure provides that, if an objection is made to a request for production based on a privilege or the work-product immunity, "the party shall make the claim expressly and shall describe the nature of the documents, communications, or things not produced or disclosed in a manner . . . that will enable other parties to assess the applicability of the privilege or protection." Fed. R. Civ. P. 26(b)(5). Tracking the language of Rule 26, Jackson/Charvel stated in its Instruction to its Requests for Production: "If any privilege is claimed with respect to any documents responsive to these requests, state the nature of the privilege claimed, all facts relied upon in support of the claim, identify all documents related to the claim and identify all persons having any knowledge of any facts related to the claim." (Exhibit B to Motion at p. 3.) Prins did not provide any descriptions of the documents (including author, date, recipient, or document type) when claiming that certain documents were privileged. Therefore, it is impossible for Jackson/Charvel to evaluate whether Prins' claims of "work-product immunity and/or other applicable privilege" have any merit. Accordingly, Jackson/Charvel requests that the Board compel Prins to provide appropriate descriptions of documents that he claims are subject to a privilege or produce the documents in question.

D. Prins' Response to Requests for Production Nos. 37 and 38

In Requests for Production Nos. 37 and 38, Jackson/Charvel requested documents received from and sent to the U.S. PTO concerning Prins' SAN DIMAS mark, as well as all documents relating to communications with any party relating to registration of Prins' SAN DIMAS mark. (See Exhibit E to Motion at p. 9.) Prins objected to both requests, stating that they sought "to discover documents that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive."⁷

These documents are obviously relevant, as they concern Prins' communications with the U.S. PTO about the protectability of his SAN DIMAS mark. Jackson/Charvel knows that Prins had such communications with the U.S. PTO based on publicly available information. For example, the U.S. PTO website indicates that Prins received via e-mail a non-final Office Action from the U.S. PTO on June 19, 2003. The U.S. PTO website also indicates that Prins responded to this Office Action. However, Prins has refused to provide these documents.

Prins is the most convenient and less expensive source for obtaining these documents. While Jackson/Charvel could contract with a third-party service to copy these documents from the U.S. PTO's files, such services are expensive. Given that Prins likely has these documents in his possession, it is not a significant burden for him to produce them to Jackson/Charvel. Accordingly, Jackson/Charvel is entitled to review all documents responsive to Request for Production Nos. 37 and 38, and the Board should compel Prins to produce such documents.

⁷ Prins' also objected that Request for Production No. 38 was "irrelevant." That objection has no merit, as communications concerning Prins' own registration may contain information that is reasonably calculated to lead to admissible evidence.

IV. PRINS' FAILURE TO SUFFICIENTLY ANSWER ADMISSION REQUESTS

In addition to the discovery requests addressed above, Jackson/Charvel also served Requests to Admit on Prins. (*See generally* Exhibit C to Motion.) Jackson/Charvel did so to narrow the issues for trial so both parties could efficiently proceed. Rather than properly responding by meeting the substance of Jackson/Charvel's Admission Requests, Prins chose to provide evasive or nonresponsive answers. Importantly, Prins affirmatively stated the same information in several of his Interrogatory Responses as Jackson/Charvel requested that he admit; however, Prins refused to admit Jackson/Charvel's Admission Requests. Prins refusal to properly admit or respond to certain of Jackson/Charvel's Admission Requests will needlessly increase the cost and complexity of this proceeding, and the Board should deem such requests admitted.

A. Prins' Response to Admission Request No. 11

In Admission Request No. 11, Jackson/Charvel asked Prins to admit that "Jackson/Charvel used the SAN DIMAS mark in connection with the sale of guitars in 2003." (Exhibit F to Motion at 3.) Prins denied this request to admit. Yet, in his answer to Interrogatory No. 23, Prins stated that Jackson/Charvel used the term "SAN DIMAS" in a trademark in 2003. (*See* Exhibit D to Motion at pp. 11-12.) Jackson/Charvel cannot understand how Prins can affirmatively state that Jackson/Charvel used the SAN DIMAS mark in 2003 when answering an Interrogatory Request but deny Request for Admission No. 11, which states the same thing. Prins' denial of Admission Request No. 11 is in bad faith, and the Board should deem such request admitted.

B. Prins' Response to Admission Requests Nos. 16, 21, and 22

In Admission Requests Nos. 16, 21, and 22, Jackson/Charvel asked Prins to admit that Jackson/Charvel has not authorized his use of Jackson/Charvel's SAN DIMAS trademark.

(See Exhibit F to Motion at pp. 3-4.) Prins does not properly answer these Admission Requests pursuant to Rule 36 of the Federal Rules of Civil Procedure. Instead he refuses to answer the requests without fairly meeting their substance, by stating: "Prins cannot admit or deny this request as Prins contends that Jackson/Charvel has no rights to a San Dimas mark that entitled Jackson/Charvel to grant such an authorization." (*Id.*)

Jackson/Charvel's Admission Requests do not assume priority of use by any party and do not assume that Jackson/Charvel has a protectable trademark. Indeed, Jackson/Charvel's Admission Requests define the term "mark" to include "trademarks, service marks, trade names, or any word or symbol utilized in connection with business activities." (Exhibit C to Motion at p. 2.) Admission Requests Nos. 16, 21, and 22 simply ask that Prins admit that Jackson/Charvel has not authorized his use of the term "SAN DIMAS," separate and distinct from whether authorization is necessary or not. The Board should require Prins to properly admit or deny Admission Requests Nos. 16, 21, and 22 or, in the alternative, deem such requests admitted.

C. Prins' Response to Admission Request No. 38

In Admission Request No. 38, Jackson/Charvel asked Prins to admit that "Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to cause confusion with Jackson/Charvel's SAN DIMAS mark." (Exhibit F to Motion at p. 6.) This Admission Request is straightforward and, if admitted, would simplify this proceeding greatly. Rather than admitting or denying this Request for Admission, Prins evasively states, "Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has not established use of a San Dimas trademark." (*Id.*) Prins response is disingenuous and conflicts with his own statements in his answers to Jackson/Charvel's Interrogatory Requests.

As noted above, in its Admission Requests, Jackson/Charvel defined the term "mark" to include "trademarks, service marks, trade names, or any word or symbol utilized in

connection with business activities." (Exhibit C to Motion at p. 2.) Therefore, Admission Request No. 38 does not imply that Jackson/Charvel has protectable rights in any mark. Furthermore, Admission Request No. 38 does not imply priority of use by either party. Rather, Admission Request No. 38 relates solely to the issue of likelihood of confusion.

In Prins' answer to Jackson/Charvel's Interrogatory No. 17, Prins affirmatively states that there is a likelihood of confusion between the parties' respective marks. (Exhibit D to Motion at pp. 9-10.) Specifically, Prins states, "Registrant contends that Petitioner's *continued use* of the term 'San Dimas' in any form *will cause mistakes and confusion* . . . with respect to products manufactured and sold by Registrant and his San Dimas Guitar Company" (*Id.* (emphasis added).) Given Prins' affirmative statement that a likelihood of confusion exists, Prins' refusal to answer Admission Request No. 38 in the affirmative is in bad faith.

This proceeding would be significantly simplified if Prins admitted Request No. 38. Both parties would be able to focus their attention and resources on contested issues concerning priority and protectability if Prins truthfully answer Jackson/Charvel's request. The Board should deem Admission Request No. 38 as admitted.


V. CONCLUSION

For the foregoing reasons, the Board should grant Jackson/Charvel's Motion in its entirety.

DATED: December 31, 2004

Respectfully Submitted,

JACKSON/CHARVEL MANUFACTURING, INC.

By 
One of Its Attorneys

Oscar L. Alcantara
Salvador K. Karottki
GOLDBERG, KOHN, BELL, BLACK,
ROSENBLUM & MORITZ, LTD.
55 East Monroe Street, Suite 3700
Chicago, Illinois 60603
(312) 201-4000

EXHIBIT 1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of
Trademark Registration No. 2,772,766
For the Mark SAN DIMAS GUITARS THE
CALIFORNIA GUITAR COMPANY
Registration Date: October 7, 2003

JACKSON/CHARVEL MANUFACTURING,
INC.,

Cancellation No. 92042614

Petitioner,

v.

PRINS, LLOYD A.,

Registrant

To: Salvador K. Karottki
Goldberg, Kohn
55 East Monroe Street, Suite 3700
Chicago, IL 60603

REGISTRANT'S FIRST INTERROGATORIES TO PETITIONER

Please take notice that Registrant Lloyd A. Prins directs the Petitioner to answer in writing under oath, fully and completely, pursuant to Rules 26 and 33 of the Federal Rule of Civil Procedure, the following Interrogatories and that the Answers be signed by the person making them and that they be served upon the Registrant within thirty (30) days after service of these Interrogatories. Petitioner is notified that these Interrogatories and the Petitioner's sworn answers to them may be offered as evidence in the above proceeding.

Instructions

In answering these Interrogatories, furnish all information which is available to Petitioner, including information in the possession of Petitioner's attorneys, for Petitioner and Petitioner's attorneys, and not merely information as may be known by Petitioner. If Petitioner cannot answer the following Interrogatories in full after exercising due diligence to secure the

information to do so, state the answer to the extent possible, specifying Petitioner's inability to answer the remainder, stating whatever information or knowledge Petitioner has have concerning the unanswered portion.

These Interrogatories shall be deemed to be continuing until and throughout the duration of proceedings.

Information sought by these Interrogatories that Petitioner obtains after Petitioner serves its answers must be disclosed by supplementary answer.

Each Interrogatory is to be answered separately as required by Rule 33(b)(1) of the Federal Rules for Civil Procedure. Pursuant to Rule 34 of the Federal Rules for Civil Procedure, please attach as exhibits all documents which have been prepared in connection with this proceeding or upon which Petitioner may rely or expect testimony to rely or such other documents as may be requested in the attached REGISTRANT'S REQUESTS FOR PRODUCTION OF DOCUMENTS.

For each answer to an Interrogatory, identify each and every document and tangible thing used in the preparation of that answer and each and every document and tangible thing that provides the factual basis for that answer. Also for each answer, identify each and every person, company and entity that furnished information in answering each Interrogatory and identify each and every person, company and entity who may offer testimony to those facts.

Definitions

The term "Document" means: all writings of any kind, including the originals and all non-identical copies, whether different from the originals by reason of any notation made on such copies or otherwise, and whether printed, recorded, created or reproduced by any mechanical means or process, or written or produced by hand, including, but not limited to; agreements; contracts; drafts of agreements or contracts; written material referencing oral agreements or contracts; letters of intent; orders; purchase orders; communications; message response; personal calendars (whether written or computerized) postcards; teletypes; telefax; mailgrams; tape

recordings; memorandums (whether written or computerized); emails; summaries; notes or other typed or written records; interoffice memoranda and communications; personal memoranda; graphic slides; pictures; motion picture films; digital images (still or motion); photographic film; microfilm, microfiche tape; cassettes; computer disks; floppy disks; mini-disks; USB flash drives; compact disks; magazines; charts; graphs; drawings; bookkeeping entries; account summaries; financial statements; balance sheets; invoices; bills; receipts; bank records, overviews and summaries; statements of witnesses; findings of investigations; pamphlets; bulletins; customer registration/warranty cards; posters; blueprints; schematics; test results; and letters.

“Identify each and every”, when used in reference to a document, means that the following information be supplied:

- 1) A description of the document;
- 2) The date of the document;
- 3) The name or names of any individual who may have authored the document or provided information for the document;
- 4) The name or names of any individual to whom the document was sent;
- 5) A general description of the subject matter of the document;
- 6) The name or names of any person who sent the document; and
- 7) The current location of the document

“Identify each and every” when used in reference to a person, a company or an entity means that the following information be supplied:

- 1) The correct name and address of that person or entity;
- 2) The correct name and address of that person’s employer and job title if reference is made to that person;
- 3) The last know whereabouts of that person; and

- 4) If the information requested contains the name of a person who is no longer employed or associated with Petitioner then Petitioner or its attorney should supply not only the correct name and last known address of that person but that person's date of birth, social security number and last known employer.

Interrogatory No. 1 Identify each and every person, company, or entity that may offer expert testimony in the above captioned proceeding and state after each person:

- A. His/her qualifications and current curriculum;
- B. The subject matter on which the expert may be called to testify;
- C. The substance of the facts and opinions to which the expert may be called to testify;
- D. A summary of the grounds for each opinion; and

Interrogatory No. 2 Identify each and every person who may offer factual testimony in the above captioned proceeding and state after each person the subject and/or subjects which he/she may be called to testify.

Interrogatory No. 3 Identify each and every person whom Petitioner claims to have knowledge of the facts and claims as set forth in its Petition to Cancel. For each person, the answer should include what knowledge it is Petitioner claims each person has.

Interrogatory No. 4 Identify each and every document and tangible thing that Petitioner claims support the facts and claims set forth in its Petition to Cancel.

Interrogatory No. 5 Set forth in detail any efforts undertaken by Petitioner or any of its employees, or by any vendor, person, company or entity acting for the Petitioner, for the

purpose of obtaining information concerning the Registrant's activities related to the San Dimas mark.

Interrogatory No. 6 Set forth in narrative form any investigations, internal or otherwise, conducted by Petitioner, where the Registrant was either directly or indirectly the focus of such investigation(s).

- A) State what type of investigation was conducted including dates, times and places;
- B) Identify any person who participated in such investigations and/or interviews and indicate whether the person was the interviewer, interviewee, observer or served any other role;
- C) Identify all documents that were generated in the course of such investigation. Include hand-written notes, minutes, follow-up memos, and employee discipline reports; and
- D) Summarize the findings of such investigation.

Interrogatory No. 7 Set forth in narrative form, any and all documentary evidence, photographs or testimony Petitioner intends to rely on that disputes the accuracy or facts of Registrants claim to the use of the San Dimas trademark.

Interrogatory No. 8 Completely list and describe all documents and other tangible things (including but not limited to tapes, photographs, diaries, logs, schedules, data files, etc) that Petitioner intends to use in the preparation the above referenced proceeding.

Interrogatory No. 9 Set forth in narrative form the facts and circumstances relate to the Petitioner's purchase of the Jackson/Charvel Division from Akai Musical Instruments

Corporation. Include the purchase price, the date of purchase, a complete list of all assets purchased, all trademarks purchased and the value of good will included in the purchase.

Interrogatory No. 10 Set forth in detail all trademarks, registered or unregistered, for which the Petitioner claims ownership. For registered trademarks provide registration. For non-registered marks, provide a description of mark, date of first use, the geographic locations where product(s) is/was sold using the non-registered mark, and date of last use.

Interrogatory No. 11 Set forth in narrative form the facts and circumstances related to all trademark for which the Petitioner is not currently using but plans to use in the future.

Identify all persons who have knowledge of such plans and **Identify all documents** and tangible things that support this answer.

Interrogatory No. 12 Set forth in detail the facts and circumstances that resulted in Petitioner's first use of the San Dimas mark. Include in the answer:

- A) The date of first use of the San Dimas trademark;
- B) The physical address of each manufacturing plant where San Dimas trademarked products were produced;
- C) A specimen of the San Dimas mark and how it was used in association with the sale of product;
- D) A listing of all employees (present and past) who were involved in the design, manufacturing, marketing and selling;
- E) Each product's serial numbers;
- F) Each product's date of manufacturing;
- G) Each product's work order or production control number;
- H) The geographic location where San Dimas trademarked items were sold; and

- I) Any and all persons credited with originating the San Dimas trademark concept.

Interrogatory No. 13 Set forth in detail the method by which Petitioner used the San Dimas mark to distinguish products sold under this mark from Petitioner's non-San Dimas products. Limit answer to products manufactured prior to October 2002.

Interrogatory No. 14 Set forth in individual year summaries, the year-end total dollar sales for all Jackson/Charvel guitars and basses for each year 1993 to present.

- A) For each year's total dollar sales, identify how many total dollars came through the sale of San Dimas trademarked product.

Interrogatory No. 15 Set forth in individual year summaries, the year-end total number of Jackson/Charvel guitars and basses sold for each year 1993 to present.

- A) For each year's total number identify how many total dollars came through the sale of San Dimas trademarked product.

Interrogatory No. 16 Set forth in specific detail the legal argument on which Petitioner claims ownership and rights to exclusive use of the San Dimas mark.

Interrogatory No. 17 Specific to the Charvel products promoted in a 1995 catalog and again in a 1996 catalog, set forth in detail the facts and circumstances surrounding the introduction and cessation of these products. Include in the answer a description of the specimen trademark; describe how this trademark was used in association with the sale of these products; and state whether these products were replicas of an earlier era product and if not, how they differed.

- A) **Identify any and all persons** who originated this concept, those who were responsible for its introduction, and those who were responsible for its cessation.

Interrogatory No. 18 Set forth in narrative form the facts and circumstances that led to Petitioner's first knowledge of Registrant's use of the San Dimas trademark.

Interrogatory No. 19 Set forth in narrative form the facts and circumstances related to the Petitioner's use of the San Dimas trademark commencing with the twenty-fifth anniversary Charvel guitar.

- A) Include the dates and times for all meetings;
- B) **Identify all persons** who participated in these meetings;
- C) Identify any product prototypes built, where they were built and **identify all persons** involved in building them; and
- D) Identify the location of the manufacturing plant where any and all products are built.

Interrogatory No. 20 Is it Petitioner's response to each request for admission served with these interrogatories an unqualified admission? If not, for each response that is not an unqualified admission:

- A) State the number of the request
- B) State the facts on which Petitioner bases its response; and
- C) State the names, addresses and telephone numbers of all persons who have knowledge of those facts.

Certificate of Mailing and Notice of Service

Certificate of Mailing (37 C.F.R. 1.10)

I certify that a copy of:

Registrant's First Interrogatories to Petitioner;
Registrant's First Request for Production of Documents; and
Registrant's First Request for Admissions to Petitioner

were mailed on September 24, 2004 via U.S. Postal Service, article number
0301 0120 0002 6146 2363. This item was deposited with sufficient
postage and was addressed to:

Box TTAB No Fee
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3513


Notice of Service

I also certify that a copy of:

Registrant's First Interrogatories to Petitioner;
Registrant's First Request for Production of Documents; and
Registrant's First Request for Admissions to Petitioner

were mailed to the Petitioner on September 23, 2003 via FedEx Overnight, article
number 839889188834. This item was deposited with sufficient
postage on _____ and addressed to:

Mr. Salvador K. Karottki
Goldberg Kohn
55 East Monroe Street
Suite 3700
Chicago, IL 60603-5802


Lloyd A. Prins Date 9/23/04